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DILUTION BY TARNISHMENT: AN UNWORKABLE CAUSE OF ACTION IN CASES OF ARTISTIC EXPRESSION

Abstract: This Note argues that the Trademark Dilution Revision Act (TDRA), enacted to provide relief to companies whose trademarks are used in tarnishing ways, is unworkable when applied to tarnishing uses in artistic works. When the TDRA was enacted in 2006, it included several amendments to current dilution law that will keep defendants who used a trademark in an expressive work free from liability no matter how tarnishing the use. Specifically, the amendments require that the mark be nationally famous and that the defendant's use of the mark be a trademark use. They also include a noncommercial use exclusion as well as a broad and loosely interpreted fair use exclusion. These amendments unfairly tilt the TDRA in favor of artists who create works for some commercial purpose. Drawing from other areas of intellectual property, this Note suggests that there is a more appropriate standard that should be applied in the TDRA's stead. In addition to not requiring a mark be nationally famous or that the tarnishing use be a trademark use, there should be a multi-factorial fair use defense similar to that of copyright law. This standard would more appropriately balance First Amendment rights of artists with mark owners' rights to preserve the reputation of their trademarks.

INTRODUCTION

In July 2010, a controversy arose in Poland surrounding an extremely large poster, which depicted the work of artist Max Papeschi and advertised an exhibition of his work at a local gallery.¹ The poster combined Mickey Mouse's image with a swastika and the body of a nude woman.² The work was part of a larger series that portrayed iconic American cartoon figures with images of destruction.³ The contrast of the familiar Mickey Mouse trademark with images of nudity and Nazism appeared to tarnish the fun-loving and child-friendly reputation of Dis-

¹ See Eric Brothers, *Naked Woman with Swastika Stirs Controversy in Poland*, SUITE 101 (Dec. 3, 2010), <http://www.suite101.com/content/max-papeschis-nazisexymouse-stirs-controversy-in-poland-a316339>; see also *infra* App.

² See Kirsten Grieshaber, *Mickey Mouse with Nazi Symbol Causes Anger in Poland*, HUFFINGTON POST (July 14, 2010), http://www.huffingtonpost.com/2010/07/14/mickey-mouse-with-nazi-sy_n_645721.html; see also *infra* App.

³ Grieshaber, *supra* note 2.

ney's Mickey Mouse trademark.⁴ Nonetheless, the Trademark Dilution Revision Act (TDRA) would fail to provide Disney any sort of protection should they decide to bring action against Max Papeschi under the TDRA.⁵

Trademark dilution doctrine seeks to protect the goodwill investment of mark holders by preventing the blurring or tarnishment of a trademark owner's famous mark.⁶ When an artist portrays a mark negatively, the public may associate the mark with the negative portrayal, thus damaging the mark's reputation and selling power.⁷ This theory of dilution is called dilution by tarnishment.⁸

Relief under this theory, however, is limited when artists use a famous trademark in their expressive work.⁹ Although the mark holder may have a cause of action for dilution by tarnishment, tension exists between recognizing such an action and protecting First Amendment rights where the tarnishing use is in an expressive work.¹⁰ Despite the 2006 passage of the TDRA, which made dilution by tarnishment a statutory cause of action for mark holders,¹¹ the Act's current textual and analytical framework is favorable to artists.¹²

In response to the number of trademark and copyright infringement cases over the last ten years, and in the wake of the TDRA, scholarship has focused on ensuring adequate First Amendment protection for artists against infringement and dilution claims.¹³ This Note, how-

⁴ See 15 U.S.C. § 1125(c) (2006); Grieshaber, *supra* note 2.

⁵ See *infra* notes 202–286 and accompanying text. By referring to Papeschi's work, I am simply providing a visual example of an artist's tarnishing use of a trademark and am not implying that Federal Trademark Dilution Act (FTDA) applies extraterritorially.

⁶ 15 U.S.C. § 1125 (c); see MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW 204–07 (2d ed. 2009) (providing a discussion on dilution theory); William Joern, *Goodwill Harboring: The Trademark Dilution Revision Act of 2006 Legitimizes the Goodwill Investment in a Trademark While Safeguarding the First Amendment*, 17 DEPAUL-LCA J. ART & ENT. L. & POL'Y 267, 302 (2007).

⁷ See LAFRANCE, *supra* note 6, at 206–07; Sarah L. Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1191 (2008) (discussing trademark dilution and the definition of dilution by tarnishment).

⁸ 15 U.S.C. § 1125(c)(2)(C).

⁹ See *infra* notes 202–286 and accompanying text.

¹⁰ See Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 898–99 (2005).

¹¹ See 15 U.S.C. § 1125(c). The Act amended the existing cause of action for dilution. See *id.*

¹² See *infra* notes 202–286 and accompanying text.

¹³ See Joern, *supra* note 6, at 302 (praising the First Amendment protection the TDRA provides artists); Lee Ann W. Lockridge, *When Is a Use in Commerce a Noncommercial Use?*, 37 FLA. ST. U. L. REV. 337, 366 (2010) (recommending a broad interpretation of the TDRA's

ever, seeks to push the debate in a new direction by suggesting that First Amendment protection in the trademark dilution context has been stretched too far, leaving corporations unable to attain even injunctive relief against diluters.¹⁴ Unlike the more tailored and flexible free speech doctrines found in the laws of trademark infringement, copyright, and right of publicity, dilution by tarnishment as constituted under the TDRA effectively prevents companies from prevailing against artists no matter how harmful the appropriation may be to the corporation's mark.¹⁵ Papeschi, for example, would be free of liability despite the extremely unsavory association of the positive Disney brand with a swastika.¹⁶

Part I of this Note introduces trademark dilution and the codification of the Federal Trademark Dilution Act (FTDA) into the Lanham Act.¹⁷ It also discusses the TDRA's enactment and its amendments to the statutory cause of action for dilution in the Lanham Act and the resulting benefits to artists.¹⁸ It then compares and contrasts the TDRA exclusions with trademark infringement's artistic relevance test.¹⁹ Part II follows this comparative analysis with one of copyright law and the balancing test courts use under the fair use doctrine.²⁰ Part III similarly examines state right of publicity statutes and compares this area of law to dilution by tarnishment.²¹ Part IV analyzes the current deficiencies under the TDRA that allow artists to escape liability.²² Part V draws from the deficiencies of Part IV and looks to copyright law and the

noncommercial use exclusions to narrow the reach of dilution liability); Jeremy M. Roe, *The Current State of Antidilution Law: The Trademark Dilution Revision Act and the Identical Mark Presumption*, 57 DEPAUL L. REV. 571, 571 (2008) (noting the positive effect of the TDRA's expanded exemptions for fair use).

¹⁴ See Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1011 (2009) (noting that trademark law permits negative depictions of marks).

¹⁵ See *id.* at 1014 (highlighting that dilution laws will not address potential harm arising from negative depictions due to the ambiguity in the current law). Compare 15 U.S.C. § 1125(c) (containing a broad set of affirmative defenses that narrow the applicability of the TDRA), with 17 U.S.C. § 107 (2006) (containing a four-factor fair use defense that does not automatically preclude claims against noncommercial uses), and 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:41 (4th ed. 2010) (noting a test some courts apply to right of publicity cases in which noncommercial uses are not immediately shielded from liability).

¹⁶ See *infra* notes 323–328 and accompanying text.

¹⁷ See *infra* notes 24–56 and accompanying text.

¹⁸ See *infra* notes 57–131 and accompanying text.

¹⁹ See *infra* notes 132–138 and accompanying text.

²⁰ See *infra* notes 139–173 and accompanying text.

²¹ See *infra* notes 174–201 and accompanying text.

²² See *infra* notes 202–286 and accompanying text.

right of publicity to suggest an alternative way in which trademark law could better serve the interests of intellectual property owners when faced with defendants who use the owners' marks in expressive works.²³

I. TRADEMARK DILUTION BY TARNISHMENT: THE CLASH OF ARTISTIC EXPRESSION AND TRADEMARK OWNERS' GOODWILL INVESTMENT UNDER THE CURRENT STATUTORY FRAMEWORK

The Lanham Act, the federal statute of trademark law, prohibits trademark dilution, trademark infringement, and false advertising.²⁴ Trademark dilution became a prohibited activity under the Lanham Act with the 1995 codification of the FTDA.²⁵ This Part examines the origins of trademark dilution and its statutory enactment under the Lanham Act.²⁶ Section A defines dilution by tarnishment.²⁷ Section B examines the codification of the FTDA and the case that ultimately led to its amendment through the TDRA in 2006.²⁸ Section C analyzes the amendments that the TDRA made to dilution law, specifically those changes benefiting artists.²⁹ Section D compares the broad TDRA exclusions with trademark infringement's more tailored artistic relevance test.³⁰

A. Origins of Trademark Dilution

Trademark dilution is the gradual corrosion of a trademark's identity or reputation.³¹ There are two types of trademark dilution: blurring and tarnishment.³² Dilution by blurring occurs when the distinctive

²³ See *infra* notes 287–338 and accompanying text.

²⁴ Trademark Act (Lanham Act) of 1946, 15 U.S.C. §§ 1051–1141n (2006).

²⁵ See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985, 985 (formerly codified at 15 U.S.C. § 1125(c) (2000)) (current version at 15 U.S.C. § 1125(c) (2006)).

²⁶ See *infra* notes 31–138 and accompanying text.

²⁷ See *infra* notes 31–40 and accompanying text.

²⁸ See *infra* notes 41–56 and accompanying text.

²⁹ See *infra* notes 57–131 and accompanying text.

³⁰ See *infra* notes 132–138 and accompanying text.

³¹ See SIEGRUN D. KANE, KANE ON TRADEMARK LAW: A PRACTITIONER'S GUIDE § 9:1.1, (5th ed. 2010); Justin J. Gunnell, *Evaluation of the Dilution-Parody Paradox in the Wake of the Trademark Dilution Revision Act of 2006*, 26 CARDOZO ARTS & ENT. L.J. 441, 446 (2008) (stating that dilution refers to an association that arises from a famous mark and a mark or trade name that either impairs the distinctiveness of the mark by blurring or harms its reputation by tarnishing).

³² 15 U.S.C. § 1125(c) (2006).

identity of a mark is weakened through its use on dissimilar products.³³ Dilution by tarnishment refers to an unauthorized use of a mark that portrays the mark in an unwholesome context “likely to evoke unflattering thoughts about the owner’s product,” thus tarnishing the goodwill investment in the mark.³⁴ The primary purpose of dilution doctrine is to protect strong marks and the mark holder’s goodwill investment in those marks.³⁵ Unlike trademark infringement where consumer confusion is the root of the problem, consumers in a dilution context remain able to identify the plaintiff’s product.³⁶ The harm under tarnishment theory instead lies in the inability of consumers to positively identify the trademark.³⁷

Because it is rare that an artist’s use of a mark would impair the mark’s distinctiveness and it is more likely to cause reputational damage to the mark, a mark holder would more likely bring an action against an artist under a tarnishment rather than a blurring theory.³⁸ Therefore, artists are unlikely targets in a dilution by blurring claim.³⁹ Rather than weaken the identity of the mark, an artist’s negative portrayal of the mark would simply tarnish the reputation of the source of the mark.⁴⁰

³³ See Gunnell, *supra* note 31, at 446–47. In determining whether a mark will cause dilution by blurring, a court will consider six factors: (1) the degree of similarity between the mark or trade name and the famous mark, (2) the degree of inherent or acquired distinctiveness of the famous mark, (3) the extent to which the owner of the famous mark is exclusively using the mark, (4) the degree of the mark’s recognition, (5) whether the use of the mark was intended to create an association with the famous mark, and (6) any actual association between the mark and famous mark. See 15 U.S.C. § 1125(c) (2) (B).

³⁴ See 15 U.S.C. § 1125(c) (2) (C); Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008) (quoting Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43 (2d Cir. 1994); Joern, *supra* note 6, at 273. This damaged reputation occurs through a defendant’s use of a mark similar to that of the mark holder in a way that creates an “undesirable, unwholesome, or unsavory mental association with the plaintiff’s mark.” See Original Appalachian Artworks v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1039 (N.D. Ga. 1986).

³⁵ See LaFrance, *supra* note 6, at 205.

³⁶ Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 903 (9th Cir. 2002); H.R. REP. NO. 104-374, at 2–3 (1995) (noting that unlike trademark infringement, dilution affects the public’s perception of a trademark without the presence of consumer confusion); Tara J. Goldsmith, *What’s Wrong with This Picture? When the Lanham Act Clashes with Artistic Expression*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 821, 859 (1997).

³⁷ See Joern, *supra* note 6, at 273.

³⁸ See Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 812 (9th Cir. 2003) (addressing dilution by tarnishment rather than blurring).

³⁹ See Joern, *supra* note 6, at 285 (discussing dilution by blurring).

⁴⁰ See *Walking Mountain Prods.*, 353 F.3d at 812.

B. *Trademark Dilution Under the Federal Trademark Dilution Act*

Dilution law first developed through state statutes after Professor Frank Schechter, in an influential law review article, suggested expanding unfair competition law to protect the uniqueness of a trademark.⁴¹ After his article, states began enacting statutes addressing dilution, and eventually Congress passed the FTDA in 1995, amending the Lanham Act to recognize anti-dilution law at the federal level.⁴² Under the FTDA, a mark holder could obtain injunctive relief against a diluter if (1) the mark was famous, (2) the junior user made “commercial use in commerce of a mark or trade name,” (3) if the use began after the mark became famous, and (4) the use caused dilution of the distinctive quality of the mark.⁴³ Congress provided three statutory exemptions: (1) fair use of a mark in comparative commercial advertising or promotion to identify the competing goods or services, (2) noncommercial use, and (3) all forms of new reporting and news commentary.⁴⁴

Notably, the FTDA, unlike its state law counterparts, did not explicitly include a cause of action for dilution by tarnishment.⁴⁵ Despite this lack of an explicit statutory cause of action, however, some lower federal courts recognized the legitimacy of dilution by tarnishment claims under federal law.⁴⁶ In addition to these courts’ acknowledging dilution by tarnishment, the FTDA’s legislative history shows Congress’s intent to protect famous trademarks from uses that may tarnish them.⁴⁷

In 2003, the U.S. Supreme Court in *Moseley v. V Secret Catalogue, Inc.* not only required a showing of *actual* dilution, but it also called into

⁴¹ See LaFRANCE, *supra* note 6, at 206 (discussing how the 1927 law review article recommended expanding trademark law beyond protecting against consumer confusion or deception); Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

⁴² See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985, 985 (formerly codified at 15 U.S.C. § 1125(c) (2000)).

⁴³ See 15 U.S.C. § 1125(c) (2000), *amended by* 15 U.S.C. § 1125(c) (2006); Burstein, *supra* note 7, at 1196 (listing the factors under the FTDA). The Act had defined dilution as the decreasing ability of a famous mark to “identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.” See 15 U.S.C. § 1125(c)(1) (2000), *amended by* 15 U.S.C. 1125(c)(1) (2006).

⁴⁴ See 15 U.S.C. § 1125(c)(4) (2000), *amended by* 15 U.S.C. 1125(c)(3) (2006).

⁴⁵ See *id.* § 1125(c)(1).

⁴⁶ See *Walking Mountain Prods.*, 353 F.3d at 812; *MCA Records*, 296 F.3d at 903 (recognizing both blurring and tarnishment).

⁴⁷ See *Walking Mountain Prods.*, 353 F.3d at 812; *MCA Records*, 296 F.3d at 903; H.R. REP. No. 104-374, at 2 (1995) (stating, however, that the “purpose of H.R. 1295 is to protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion”).

question the existence of dilution by tarnishment as a cause of action under the FTDA.⁴⁸ The Court cast a shadow over the FTDA when it required that mark holders show *actual* dilution to prevail on their dilution claims and then stated that dilution by tarnishment was not a federal cause of action.⁴⁹ The case concerned a dilution action between Victoria's Secret, a lingerie company, and Victor's Little Secret, a small adult novelty store.⁵⁰ Victoria's Secret sought injunctive relief against the defendant's use of "Victor's Little Secret" as the store's name.⁵¹ The Supreme Court rejected the lower court's grant of an injunction, concluding that the FTDA required a showing of *actual* dilution by objective proof of actual injury to the economic value of the mark.⁵² Under this actual dilution standard, the Court reasoned that Victoria's Secret had insufficient evidence to prove actual dilution.⁵³

In addition to holding that Victoria's Secret failed to show actual dilution to the mark, the Court noted that tarnishment is not a specific cause of action under the FTDA.⁵⁴ Whereas state anti-dilution statutes explicitly reference tarnishment, the Court reasoned, the FTDA's statutory text did not embrace tarnishment actions.⁵⁵ In ruling so, the Court refused to give credit to the fact that the FTDA's legislative history mentions tarnishment.⁵⁶

⁴⁸ See 537 U.S. 418, 432–33 (2003).

⁴⁹ See *id.*; Roe, *supra* note 13, at 578–80.

⁵⁰ See *Moseley*, 537 U.S. at 422.

⁵¹ See *id.* The lower court granted the injunction, holding that Victoria's Secret had produced sufficient evidence of a likelihood of dilution, and the appeals court affirmed. *V Secret Catalogue, Inc. v. Moseley*, No. 3:98CV-395-S, 2000 WL 370525, at *6 (W.D. Ky. Feb. 9, 2000), *aff'd*, 259 F.3d 464 (6th Cir. 2001), *rev'd*, 537 U.S. 418 (2003).

⁵² See *Moseley*, 537 U.S. at 432–33 (looking to the text of the FTDA, and holding that the "FTDA . . . provides that 'the owner of a famous mark' is entitled to injunctive relief against another person's commercial use of a mark or trade name if that use 'causes dilution of the distinctive quality' of the famous mark" (emphasis added)); see also Joern, *supra* note 6, at 279.

⁵³ See *Moseley*, 537 U.S. at 434.

⁵⁴ See *id.*

⁵⁵ See *id.* The Court stated:

Whether [tarnishment] is actually embraced by the statutory text, however, is another matter. Indeed, the contrast between the state statutes, which expressly refer to both "injury to business reputation" and to "dilution of the distinctive quality of a trade name or trademark," and the federal statute which refers only to the latter, arguably supports a narrower reading of the FTDA.

Id.; see also Roe, *supra* note 13, at 579 (discussing the *Moseley* Court's questioning of whether the FTDA included tarnishment as a cause of action).

⁵⁶ See *Moseley*, 537 U.S. at 432; H.R. REP. NO. 104-374, at 2 (1995).

*C. Dilution by Tarnishment Under the TDRA: Effectively Providing
Greater Protection for Artists*

After the Supreme Court held that the FTDA required proof of actual dilution rather than a likelihood of dilution, Congress enacted the TDRA in 2006 to overrule *Moseley* and make clear that mark holders need only prove a likelihood of dilution.⁵⁷ In passing the TDRA, Congress also explicitly incorporated dilution by tarnishment in the statutory text.⁵⁸ A dilution action under the TDRA has three elements: (1) the famous mark must be distinctive, (2) another person must use a mark or trade name in commerce after the owner's mark has become famous, (3) the use must be likely to cause dilution by blurring or *tarnishment* of the famous mark regardless of any confusion, competition, or actual economic injury.⁵⁹

But the TDRA, by amending the Lanham Act and broadening the defenses, also undercut the benefits for mark holders.⁶⁰ Thus although the TDRA was enacted to remedy the *Moseley* holding and make it easier for mark holders to show dilution, it also created greater loopholes through which artists could escape dilution liability.⁶¹

1. Statutory Changes Favoring Mark Holders: Tarnishment and the "Likelihood Standard"

Through the TDRA, Congress made two key changes favorable to mark holders.⁶² First, Congress explicitly established dilution by tarnishment as a federal cause of action and defined the term specifically.⁶³ Replacing the general definition of dilution from the FTDA, the TDRA defines dilution by tarnishment as the "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark."⁶⁴ Unlike the FTDA's general definition of "dilution"—which focused on the capacity of a mark

⁵⁷ See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1730-32 (2006) (codified at 15 U.S.C. § 1125(c) (2006)); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264 n.2 (4th Cir. 2007); *Roe*, *supra* note 13, at 580.

⁵⁸ See 15 U.S.C. § 1125(c)(1); *Roe*, *supra* note 13, at 581.

⁵⁹ 15 U.S.C. § 1125(c)(1).

⁶⁰ See *id.* § 1125(c); *Roe*, *supra* note 13, at 580-88.

⁶¹ See *infra* notes 62-131 and accompanying text.

⁶² See 15 U.S.C. § 1125(c); *Roe*, *supra* note 13, at 581.

⁶³ See 15 U.S.C. § 1125(c); H.R. REP. NO. 109-23, at 3 (2005).

⁶⁴ 15 U.S.C. § 1125(c)(2)(C).

to identify goods—the TDRA’s definition of dilution by tarnishment emphasizes the possibility of harm to the mark’s reputation.⁶⁵

Second, responding to *Moseley*’s requirement of a showing of actual dilution, the TDRA extended the cause of action to any use of a mark that is “likely” to cause dilution by tarnishment.⁶⁶ By only requiring a likelihood of tarnishment rather than actual tarnishment, Congress lowered the burden of proof on the trademark holder.⁶⁷ The TDRA also creates a rebuttable presumption that a mark, identical or substantially similar to the original mark, is likely to tarnish the famous mark.⁶⁸ Thus if an artist appropriates a mark, the burden is placed on the artist to show that there is no likelihood of tarnishment.⁶⁹ The lower burden of proof for mark holders should give them a greater chance of winning dilution actions.⁷⁰

2. Changes in the Statutory Language That Favor Defendants

Nonetheless, the statutory changes which seemingly favor the mark owner are counterbalanced by other language in the TDRA that provides additional support to accused diluters, especially artists.⁷¹ Of these protections, the two most relevant are (1) the interpretation of the statute’s “use of a mark” language, which requires that the unauthorized use be a trademark use—that is, the defendant must use the mark as his own trademark rather than generally appropriating it in a distasteful manner—and (2) the requirement that the mark be nationally famous.⁷²

⁶⁵ See *id.*

⁶⁶ See *id.* § 1125(c)(1).

⁶⁷ H.R. REP. NO. 109-23, at 3, 5; see *Moseley*, 605 F.3d at 388; *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 462 (4th Cir. 1999) (stating that plaintiffs had to show actual economic loss), *superseded by statute*, 15 U.S.C. § 1125(c)(1); see also *Roe*, *supra* note 13, at 582 (stating other reasons for having a “likelihood” standard, such as aligning with state antidilution laws, following the FTDA’s legislative history, and becoming more consistent with trademark infringement law, which requires a likelihood standard for determining consumer confusion).

⁶⁸ See *Moseley*, 605 F.3d at 388–89.

⁶⁹ See *id.* (finding that the store Victor’s Secret could not overcome this presumption of tarnishment).

⁷⁰ See *Roe*, *supra* note 13, at 582.

⁷¹ See *id.* at 585.

⁷² See 15 U.S.C. § 1125(c)(1), (2)(A) (2006); *Burstein*, *supra* note 7, at 1216–24; *Roe*, *supra* note 13, at 585.

Implicit in the statutory language is the requirement that the mark be used as a designation of source—that is, as a trademark.⁷³ To be found liable for dilution by tarnishment, the accused use must be of “a mark or trade name.”⁷⁴ In other words, an artist is only liable if he used a mark identical or similar to the holder’s mark as the artist’s own trademark.⁷⁵

The second change wrought by the TDRA regards the fame of the mark.⁷⁶ Despite strong recognition in a particular market, a mark owner cannot make a federal claim for dilution by tarnishment unless the mark is nationally famous.⁷⁷ Congress limited the scope of dilution actions to nationally famous marks in two ways.⁷⁸ First, the TDRA provides that a mark is famous only if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”⁷⁹ This language was not in the FTDA.⁸⁰ Second, the TDRA eliminates several factors that courts used under the FTDA to recognize niche market fame.⁸¹ Under the

⁷³ See Burstein, *supra* note 7, at 1221. The statute provides injunctive relief to owners of famous marks whose marks are blurred or tarnished by another person who “commences use of a *mark or trade name* . . .” 15 U.S.C. § 1125(c)(1) (emphasis added); Burstein, *supra* note 7, at 1223 (noting that the Lanham Act defines “trade name” and “mark” to include an essential element that the mark be used to indicate the source of the goods or services); see also *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 112 (2d Cir. 2010) (finding that the dilution claim failed because eBay did not use the Tiffany marks to refer to eBay’s own product). Although this requirement is not an explicit change from the FTDA, post-TDRA courts have interpreted the language as a requirement, while before the enactment of the TDRA it was not regularly mentioned in cases. Compare *Tiffany*, 600 F.3d at 112 (requiring the use to be a trademark use), and *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 112 (2d Cir. 2009) (requiring the use to be a trademark use), with *Walking Mountain Prods.*, 353 F.3d at 812 (applying the FTDA to an artistic work not used as a trademark, and neglecting to discuss any requirement that the use of the Barbie mark be as the artist’s own trademark).

⁷⁴ 15 U.S.C. § 1125(c)(1); *Haute Diggity Dog*, 507 F.3d at 265; Burstein, *supra* note 7, at 1223 (noting that the Lanham Act defines “trade name” and “mark” to include an essential element that the mark be used to indicate the source of the goods or services).

⁷⁵ See 4 MCCARTHY, *supra* note 15, § 24:122.

⁷⁶ See 15 U.S.C. § 1125(c)(2)(A).

⁷⁷ See Burstein, *supra* note 7, at 1217.

⁷⁸ See 15 U.S.C. § 1125(c)(2)(A).

⁷⁹ *Id.*

⁸⁰ See *id.* § 1125(c).

⁸¹ See *id.* § 1125(c)(2)(A). In determining whether a mark is famous, the Court now considers four factors:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

FTDA there were eight factors used to determine the fame of a mark.⁸² Although some courts required that a mark be nationally famous to receive protection, others looked to the fame factors, holding a mark famous if it was recognizable only in a niche market.⁸³ This niche market theory allowed mark holders with marks not recognized by the U.S. public at large to still qualify as sufficiently famous.⁸⁴ With the TDRA's requirement that the mark be widely recognized by the U.S. public and the elimination of several of the fame factors, mark holders with lesser known marks will have greater difficulty bringing dilution actions.⁸⁵ In the 2008 case *Board of Regents, University of Texas System ex rel. University of Texas at Austin v. KST Electric, Ltd.*, decided by the U.S. District Court for the Western District of Texas, the University of Texas sued for the misuse of its Longhorn logo.⁸⁶ The court found that although the logo was part of a niche market, "[I]t was not at all clear whether someone who

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Id. § 1125(c) (A) (i)–(iv). The TDRA eliminated four factors from the FTDA's list of eight, including "channels of trade for the goods or services with which the mark is used" and the "degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner," in order to effectively eliminate the niche market theory. *See* 15 U.S.C. § 1125(c) (1) (E), (F) (2000), *amended by* 15 U.S.C. § 1125 (2006) (emphasis added).

⁸² The eight factors used to determine the requisite fame of the mark were

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods and services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c) (1) (A)–(H) (2000), *amended by* 15 U.S.C. § 1125(c) (2) (A) (i)–(iv) (2006).

⁸³ *See* *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 908 (9th Cir. 2002) (holding that plaintiff's use of mark in a narrow market is sufficient to meet the requirement that a mark be famous); *Burstein*, *supra* note 7, at 1216.

⁸⁴ *See* *Joern*, *supra* note 6, at 283–84.

⁸⁵ *See* *Bd. of Regents, Univ. of Tex. System ex rel. Univ. of Tex. at Austin v. KST Elec.*, Ltd., 550 F. Supp. 2d 657, 675 (W.D. Tex. 2008).

⁸⁶ *See id.* at 663.

was not a fan of college football would recognize the logo as being associated with the university.”⁸⁷

3. The Broadened Exclusions from Liability

The TDRA vastly expanded the defenses available to artists under the FTDA.⁸⁸ Under the FTDA, there were three statutory exemptions: (1) fair use in comparative advertising or promotion to identify the competing goods or services, (2) news reporting and news commentary, and (3) noncommercial use.⁸⁹ The TDRA retained the latter two exceptions and significantly expanded the fair use exception.⁹⁰ The fair use exception now provides for protection for “any fair use, including a nominative or descriptive fair use . . . including use in connection with (i) advertising or promotion that permits consumers to compare goods or services; (ii) or identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”⁹¹ The TDRA thus expanded the narrow fair use in advertising to the much broader nominative and descriptive fair use in not only advertising but also in parodying, criticizing, or commenting upon the famous mark.⁹² This Section first discusses the retention of the noncommercial use exception.⁹³ Then it addresses the expansion of the fair use exception to include nominative fair use and parody.⁹⁴

⁸⁷ See *id.* at 677 (holding that the mark was not sufficiently famous despite the fact that University of Texas football games are regularly nationally televised on ABC and ESPN with over thirty-five million viewers and the Longhorn silhouette logo is prominently featured as University of Texas’s logo during these broadcasts).

⁸⁸ See 15 U.S.C. § 1125(c)(3) (2006). The American Civil Liberties Union (ACLU) took great pains to ensure that trademark owners did not infringe upon free speech rights, winning broad exclusions in the TDRA under which artists can take cover. See Joern, *supra* note 6, at 292–94 (writing about the ACLU’s concern with safeguarding the First Amendment from the TDRA). The ACLU believed that changing the requirement from a showing of actual dilution to a likelihood standard could enable mark holders to impinge upon free speech rights. See *Trademark Dilution Revision Act of 2005: Hearing on H.R. 638 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 31–37 (2005) (statement of Mr. Marvin J. Johnson, Legislative Counsel, ACLU) [hereinafter *TDRA Hearing*].

⁸⁹ See 15 U.S.C. § 1125(c)(4) (2000), amended by 15 U.S.C. § 1125(c)(3) (2006).

⁹⁰ See 15 U.S.C. § 1125(c)(3) (2006).

⁹¹ See *id.* § 1125(c)(3)(A)(i), (ii).

⁹² See *id.*

⁹³ See *infra* notes 95–106 and accompanying text.

⁹⁴ See *infra* notes 107–131 and accompanying text. Before the inclusion of parody under the TDRA’s fair use exception, courts had to fit parody under the noncommercial use exception. See *Walking Mountain Prods.*, 353 F.3d at 812 (finding that an artistic parody would be protected as a form of noncommercial expression, and as such, holding that the

In retaining the exemption for noncommercial uses, Congress attempted to balance the intellectual property rights of mark holders with the First Amendment right to free expression.⁹⁵ Prior to the TDRA, the noncommercial use exception was defined by referring to the definition of commercial speech in First Amendment law.⁹⁶ In 2002 in *Mattel, Inc. v. MCA Records*, the U.S. Court of Appeals for the Ninth Circuit differentiated commercial from noncommercial speech by stating that if speech is “not ‘purely commercial’—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.”⁹⁷ Post-TDRA, courts have continued to look at the noncommercial use exemption through the lens of commercial speech under First Amendment case law.⁹⁸ Thus even if a defendant’s use of a mark is “in commerce”⁹⁹ as required by the TDRA, the noncommercial use exemption will release the defendant from liability, provided their primary purpose in using the mark was not commercial.¹⁰⁰

With many contemporary artists striving for commercial success in the art market, the rigid interpretation of the noncommercial use defense seems inapplicable to uses of trademarks in art.¹⁰¹ Under the current statutory framework, a use will be shielded as noncommercial unless the use of the mark is inherently commercial.¹⁰² But in an art world that is increasingly commercial—with international art auctions generating billions of dollars in sales—the primary purpose of creating such

artist’s photographs subjecting Barbie to disturbing physical positions constituted noncommercial speech).

⁹⁵ See *MCA Records*, 296 F.3d at 906.

⁹⁶ See *id.*; Lockridge, *supra* note 13, at 366.

⁹⁷ See 296 F.3d at 906 (emphasis added).

⁹⁸ See *Smith*, 537 F. Supp. 2d at 1339–40.

⁹⁹ See 15 U.S.C. § 1125(c)(1) (2006). The TDRA’s cause of action for injunctive relief now reads “the owner of a famous mark . . . shall be entitled to an injunction against another person who . . . commences use of a mark or trade name *in commerce* . . .” *Id.* (emphasis added). The “use in commerce” requirement is explained by the Lanham Act, which states that a mark is used in commerce on goods “when—(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce . . .” *Id.*

¹⁰⁰ See *MCA Records*, 296 F.3d at 906; *Smith*, 537 F. Supp. 2d at 1339–40.

¹⁰¹ See *MCA Records*, 296 F.3d at 906; *Roxbury Entm’t v. Penthouse Media Grp., Inc.*, 669 F. Supp. 2d 1170, 1175 (C.D. Cal. 2009) (noting that films are considered noncommercial speech).

¹⁰² See *Smith*, 537 F. Supp. 2d at 1339.

works becomes unclear.¹⁰³ Contemporary artworks have generated hundreds of millions in revenue via public auctions and commercial advertising in November 2011 alone.¹⁰⁴ This commercial market is due in part to technological advances over the last several years—advances including online databases through which collectors worldwide can take part in multi-million dollar transactions, virtual art fairs, and real-time online bidding.¹⁰⁵ Nonetheless, in the context of trademarks, courts have not recognized the blurred line between commercial and noncommercial speech.¹⁰⁶

In addition to the retention of the noncommercial use exception, the TDRA extended the Fair Use exception to include nominative fair use.¹⁰⁷ Max Papeschi, as well as any other artist appropriating a famous mark, would easily be able to use nominative fair use as a defense to a potential dilution suit.¹⁰⁸ Despite its inclusion in trademark dilution, nominative fair use was developed in the trademark infringement context.¹⁰⁹ In 1992, the U.S. Court of Appeals for the Ninth Circuit, in *New Kids on the Block v. News America Publishing, Inc.*, defined “nominative fair use” as a use of a mark that is permissible because the junior user uses

¹⁰³ See Kelly Crow, *New Buyers Bring Art Market Back to Glory*, WALL ST. J., Jan. 28, 2011, at B1 (reporting that Christie’s sold \$5.25 billion worth of art in 2010 and Sotheby’s sold \$4.3 billion in 2010).

¹⁰⁴ See Press Release, Sotheby’s, Sotheby’s Contemporary Art Evening Sale Totals Outstanding \$315,837,000 (Nov. 9, 2011), <http://www.sothebys.com/content/dam/sothebys/PDFs/Contemporary-Evening-Nov11.pdf>. The sale total for Sotheby’s November 2011 Contemporary Art Evening Sale was \$315,837,000. *Id.*

¹⁰⁵ See Eileen Kinsella, *A Guide to the Virtual Art Market*, ARTNEWS, Nov. 2010, at 99, 103 (writing that the “instantaneous dissemination of information and images made possible by technology has had a major impact on the art world,” and that “today . . . artists create styles that they keep churning out, like a brand”).

¹⁰⁶ See *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 974 (C.D. Cal. 2007) (stating that Fox’s use of the Charwoman character is a form of noncommercial expression as it does more than propose a commercial transaction and is thus not subject to a dilution suit).

¹⁰⁷ See 15 U.S.C. § 1125 (c) (3) (A) (2006). The fair use exception also includes descriptive use in which a mark is used purely for its descriptive quality to describe one’s own product. 2 MCCARTHY, *supra* note 15, § 11:45.

¹⁰⁸ See *Tiffany*, 600 F.3d at 112; *Walking Mountain Prods.*, 353 F.3d at 812. The nominative fair use defense may also prove unnecessary, provided courts continue to require that the contested use of a mark be a trademark use. See *Tiffany*, 600 F.3d at 112; Burstein, *supra* note 7, at 1225, 1244. If the junior user must use the mark as a trademark in order to fall within the scope of the statute, then the nominative fair use exception (which exempts non-trademark uses) is irrelevant. See Burstein, *supra* note 7, at 1225, 1244 (noting the contradiction between the trademark use requirement and the nominative fair use exception).

¹⁰⁹ See *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). In this case, a music group brought suit against newspapers for infringing upon the group’s trademark in polls on the group’s popularity. See *id.* at 302.

the mark in a non-confusing way for the purpose of identifying the mark holder's goods or services.¹¹⁰ Nominative fair use thus excuses artists who use a trademark to describe or identify a mark holder's product for purposes of criticism or reference.¹¹¹ Papeschi clearly used the mark not to describe his own product, but to identify the Disney brand within his artwork.¹¹²

Dilution by tarnishment now shares this nominative fair use defense with trademark infringement even though it does not share trademark infringement's concern for likelihood of confusion.¹¹³

¹¹⁰ 971 F.2d at 308. There is also the classic fair use defense, an affirmative defense in which the junior user asserts he is using the trademark in good faith in its descriptive sense to describe the junior user's own product. 2 McCARTHY, *supra* note 15, § 11:45 ("When the plaintiff chooses a mark with descriptive qualities, the fair use doctrine recognizes that 'he cannot altogether exclude some kinds of competing uses, particularly those which use words in their primary descriptive and nontrademark sense.'" (quoting *U.S. Shoe Corp. v. Brown Grp., Inc.*, 740 F. Supp. 196, 198 (S.D.N.Y. 1990), *aff'd*, 923 F.2d 844 (2d Cir. 1990))).

¹¹¹ See *Walking Mountain Prods.*, 353 F.3d at 809–10; *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801, 806 (9th Cir. 2002); Burstein, *supra* note 7, at 1242–43. Because the Lanham Act does not explicitly define nominative fair use and because courts deciding infringement cases have not all followed the Ninth Circuit's nominative fair use test, it is unclear as to how courts in the dilution context will apply this defense. See 15 U.S.C. § 1125(c)(3)(A) (2006); Burstein, *supra* note 7, at 1242–44 (discussing the confusion around how the courts will apply the test for nominative fair use as it stems from the infringement context); see also *New Kids on the Block*, 971 F.2d at 308. Trademark infringement's three-part test for determining whether nominative use becomes nominative fair use is as follows: (1) plaintiff's product or service in question must be one not readily identifiable without use of the trademark, (2) only so much of the mark can be used as necessary to identify the plaintiff's product or service, and (3) the user must do nothing to suggest sponsorship or endorsement by the trademark holder. *New Kids on the Block*, 971 F.2d at 308. Nominative fair use has also been inconsistently applied in the infringement context. See *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 232 (3d Cir. 2005); *Playboy Enters.*, 279 F.3d at 801. Since *New Kids on the Block*, the Ninth Circuit has held that nominative fair use is not an affirmative defense as classic fair use is, but instead, when the analysis is relevant, the court should apply the three-part test of *New Kids on the Block* instead of the standard eight-part test for likelihood of confusion. See *Playboy Enters.*, 279 F.3d at 801 (finding that the three-factor test should be applied instead of the test for likelihood of confusion). The Third Circuit, however, has used the Ninth Circuit's nominative fair use as an affirmative defense like classic fair use. See *Century 21 Real Estate Corp.*, 425 F.3d at 232 (applying a slightly modified three factor nominative use test adapted from *New Kids on the Block* as an affirmative defense).

¹¹² See *infra* App.

¹¹³ See *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1098–99 (9th Cir. 2008) (recognizing nominative use doctrine in an infringement context, protecting those who use another's trademark for comparison, criticism, or point of reference); *Haute Diggity Dog*, 507 F.3d at 266 (noting that nominative fair use is a statutory defense under the TDRA); Christine Haight Farley, *Why Are We Confused About the Trademark Dilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J., 1175, 1176 (2006) (noting dilution law's disregard for the confusion test).

Whereas dilution by tarnishment claims rest upon the theory of protecting the goodwill of the mark holder, trademark infringement claims rely upon the underlying rationale of preventing consumer confusion as to the source or sponsor of a good or service.¹¹⁴ Using the nominative fair use defense in an infringement context as an example, artists can argue they use trademarks in a non-confusing way in order to describe the mark holder's products.¹¹⁵ This was the case in 2003 in *Mattel, Inc. v. Walking Mountain Productions* before the Ninth Circuit.¹¹⁶ There, an artist incorporated images of Barbie in his photographs in less than favorable settings and positions.¹¹⁷ The court held the artist was not liable for trademark infringement because there was no likelihood that the public would believe Mattel endorsed the photographs and therefore there was no confusion.¹¹⁸ This policy of preventing consumer confusion animates the law of trademark infringement.¹¹⁹ Thus when the use of a trademark poses no risk of confusion, punishment of the junior user serves no purpose.¹²⁰ Dilution law, on the other hand, does not share trademark infringement's concern with confusion but it now shares its nominative use defense.¹²¹

The TDRA also now explicitly includes parody as a fair use defense.¹²² The fair use exception includes "identifying and *parodying*, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner."¹²³ A tarnishing use will not be actionable dilution if it parodies the famous mark or the goods or services

¹¹⁴ See 15 U.S.C. § 1125(c); Roe, *supra* note 13, at 573.

¹¹⁵ See *New Kids on the Block*, 971 F.2d at 308.

¹¹⁶ See 353 F.3d at 808.

¹¹⁷ See *id.* at 796. An example of one of the artist's works was his "Fondue a la Barbie," which depicts Barbie heads in a fondue pot. *Id.*

¹¹⁸ See *id.* at 808–12 (using the nominative fair use and not the artistic relevance test because a trade dress, not trademark, was involved). The artist was referring to Barbie as a point of reference, and as such, his use of the trade dress in Mattel fit within the nominative fair use exception. See *id.* In cases of nominative fair use, there is no concern for likelihood of confusion regarding the sponsorship or endorsement of a product because the mark is in fact describing plaintiff's product. See *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 907–08 (9th Cir. 2003).

¹¹⁹ See *New Kids on the Block*, 971 F.2d at 305–06.

¹²⁰ See 4 McCARTHY, *supra* note 15, § 23:11.

¹²¹ 15 U.S.C. § 1125(c) (1), (3) (A) (2006).

¹²² See *id.* § 1125(c) (3) (A) (ii); Gunnell, *supra* note 31, at 442. With parody now a bright line exception, a consistent definition of parody in a dilution context is vital and will be discussed in Part V. See *infra* notes 310–322 and accompanying text. It is important to note that if a diluter uses the mark as his own source designation, then a parody defense would not apply as the statute forbids fair use when the mark is used as its own source designation. See *Haute Diggity Dog*, 507 F.3d at 266.

¹²³ 15 U.S.C. § 1125(c) (3) (A) (ii).

of the mark owner.¹²⁴ Courts have not addressed whether the mark must be the target or merely a weapon of the parody.¹²⁵ In 2007, the U.S. Court of Appeals for the Fourth Circuit in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog* defined parody as “a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”¹²⁶ The court explained that the parody must convey that it is the original but at the same time not the original and instead, a parody.¹²⁷ In indicating the mark is a parody, it must not only differentiate the parody from the original mark, but must also communicate “satire, ridicule, joking, or amusement.”¹²⁸ This somewhat complex definition of parody has been relied upon by other courts.¹²⁹ The definition, however, bears no mention of the extent to which the mark must be the *subject* of the parody.¹³⁰ With the broadening of the fair use defense to include nominative fair use and an unclear understanding of parody, artists may have greater protection.¹³¹

D. *Comparison of the TDRA Defenses to Trademark Infringement’s Artistic Relevance Test*

Although trademark infringement and dilution both recognize the nominative fair use defense, only trademark infringement law specifically addresses use of a trademark in an artistic context.¹³² In contrast to trademark dilution law’s balancing of the public’s interest with that of the mark owners’ via the TDRA exemptions, courts in the trademark

¹²⁴ See *id.*; *Smith*, 537 F. Supp. 2d at 1340 (finding that defendant’s domain names and website merchandise analogizing Wal-Mart to Nazis and al-Qaeda were parodic works considered noncommercial speech and therefore not subject to Wal-Mart’s trademark dilution claims).

¹²⁵ See *Walking Mountain Prods.*, 353 F.3d at 812; *Smith*, 537 F. Supp. 2d at 1316; Gunnell, *supra* note 31, at 468–69; Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 1, 67 (1992) (arguing that fair use should provide a defense to copyright infringement only if the parody uses the work as a target).

¹²⁶ 507 F.3d at 260.

¹²⁷ *Id.*

¹²⁸ *Id.* (noting that a parody relies upon a difference from the original mark, presumably a humorous difference).

¹²⁹ See *Starbucks Corp.*, 588 F.3d at 113; *Smith*, 537 F. Supp. 2d at 1316.

¹³⁰ See *Haute Diggity Dog*, 507 F.3d at 260 (noting that the Louis Vuitton handbags are the target of the imitation of the parody, but only to assure that the parody represents the original mark); Gunnell, *supra* note 31, at 465–68. *But see* Burstein, *supra* note 7, at 1244 (interpreting the TDRA parody exclusion to mean that the parodist must actually target the mark).

¹³¹ See *supra* notes 107–130 and accompanying text.

¹³² See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

infringement context have recognized the existence of an Artistic Relevance Test that balances the public interest in avoiding consumer confusion with the public interest in free expression.¹³³

In the landmark 1989 decision *Rogers v. Grimaldi*, the U.S. Court of Appeals for the Second Circuit introduced the Artistic Relevance Test to balance an artist's rights to free expression with the mark holder's rights under the Lanham Act.¹³⁴ In *Grimaldi*, the Second Circuit concluded that the Lanham Act does not apply to artistic works unless the public interest in avoiding consumer confusion outweighs the public interest in free expression.¹³⁵ That balance will normally not support application of the Lanham Act unless the title—or artistic work in general—has no artistic relevance to the work, or, if it has some artistic relevance, unless the title misleads as to the source or content of the work.¹³⁶ The Artistic

¹³³See *id.*; Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1308–09 (2011) (noting that when a claim is based on a trademarked brand in art, courts construct balancing tests to address First Amendment concerns). There have been two other tests that address First Amendment concerns: the likelihood of confusion test and the alternative avenues test. See *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003). Under the likelihood of confusion test, the court asks whether the alleged infringement was likely to cause public confusion as to the source or sponsor of a particular good or service. See *id.* at 445, 447; *Dallas Cowboys Football Club, Ltd. v. Am.'s Team Props., Inc.*, 616 F. Supp. 2d 622, 636 (N.D. Tex. 2009). This test has been reserved, however, for traditional trademark cases where artistic use is not at issue, as it does not always adequately give weight to First Amendment interests. See *Parks*, 329 F.3d at 447–49. Under the alternative avenues test, a title of an expressive work will not be protected if there are sufficient alternative means for an artist to convey his or her idea. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (finding that a company releasing a pornographic film had other available avenues of expressing their message). This approach has been rejected on the basis that it calls for courts to suggest that artists could just have easily expressed their message without using the mark. See *Parks*, 329 F.3d at 450.

¹³⁴See 875 F.2d at 999 (creating a test that would more sufficiently accommodate public interest in free expression). In the case, actress Ginger Rogers sued an artist, who used her name in the title of a fictional movie, for trademark infringement. See *id.* at 996.

¹³⁵See *id.* at 999. This test has been adopted by panels in the U.S. Courts of Appeals for the Second, Fifth, Sixth, Ninth, and Tenth Circuits as the most appropriate way of balancing the competing interests of artists and trademark holders. See *Parks*, 329 F.3d at 1742; *MCA Records*, 296 F.3d at 902; *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989); Kerry Timbers & Julia Huston, *The "Artistic Relevance Test" Just Became Relevant: The Increasing Strength of the First Amendment as a Defense to Trademark Infringement and Dilution*, 93 TRADEMARK REP. 1278, 1290–95 (2003).

¹³⁶See *Cliffs Notes*, 886 F.2d at 495 (holding that the *Rogers* balancing approach extends beyond titles and is more broadly applicable to Lanham Act claims against works of artistic expression); *Grimaldi*, 875 F.2d at 999. Under the first prong of the test, First Amendment protection is guaranteed unless the use of the trademark has zero artistic relevance to the work as a whole. See *Grimaldi*, 875 F.2d at 999. The second prong of the test states that even

Relevance Test operates under the rationale that artistic expression is a form of speech owed special protection under the First Amendment, but not absolute immunity.¹³⁷ The TDRA's rigid defenses, on the other hand, bear no recognition to the limits of artistic expression.¹³⁸

II. ARTISTIC EXPRESSION AND COPYRIGHT LAW

Unlike the broad statutory exclusions under the TDRA, the Copyright Act uses a four factor "fair use" test to ensure that First Amendment concerns are met.¹³⁹ The U.S. Supreme Court has held that the fair use doctrine fully accommodates the tension between copyright protection and free speech.¹⁴⁰ This test, as well as the artistic relevance test, allows courts to conduct a more flexible analysis than is permitted by the stone-carved statutory exceptions shielding artists from liability in the TDRA.¹⁴¹ This Part continues to address the tension between First Amendment rights and intellectual property rights by reference to the fair use balancing test in copyright law.¹⁴²

A. Copyright Infringement and the Fair Use Defense

Just as dilution by tarnishment protects the goodwill investment of mark holders, copyright protection similarly extends to an author's

if there is some artistic relevance, use of the mark will still be actionable if it explicitly misleads as to the source or content of the work. *See id.* In *Walking Mountain Products*, for example, an analysis of the two prongs showed that the public interest in free expression outweighed any potential consumer confusion surrounding the sponsorship of the work. *See* 353 F.3d at 807. Weighing in favor of the artist under the first prong of the test, the use of the Barbie name in the title of the work accurately described the subject of the photographs, so was relevant to the work. *See id.* Second, the court found that the titles did not explicitly mislead as to Mattel's sponsorship of the works. *See id.*

¹³⁷ *See Grimaldi*, 875 F.2d at 999. One court has gone as far as to say that the First Amendment "cannot permit anyone who cries 'artist' to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be." *See Parks*, 329 F.3d at 447.

¹³⁸ *Compare* 15 U.S.C. § 1125(c)(3) (2006) (including three broad defenses excluding artists from liability), *with Grimaldi*, 875 F.2d at 999 (applying a test specifically designed to balance trademark policy with First Amendment concerns in artistic works).

¹³⁹ *See Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992); *Universal City Studios, Inc. v. Remaides*, 82 F. Supp. 2d 211, 220 (S.D.N.Y. 2000).

¹⁴⁰ *See Universal City Studios*, 82 F. Supp. 2d at 220 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985)). Expression prohibited by the Copyright Act and not within the realm of the fair use exception is considered unprotected by the First Amendment. *See id.*

¹⁴¹ *See Koons*, 960 F.2d at 308–09; Gulasekaram, *supra* note 10, at 887 (noting that in trademark law mark owners should rarely prevail).

¹⁴² *See infra* notes 143–173 and accompanying text.

honor and reputation.¹⁴³ Section 106 of the Copyright Act confers exclusive rights to the copyright owner.¹⁴⁴ A *prima facie* claim of copyright infringement requires the ownership of a valid copyright and the copying of original elements of the work.¹⁴⁵

The Copyright Act's fair use doctrine adequately balances the constitutional grant of copyright protection with free speech under the First Amendment.¹⁴⁶ Despite the constitutional right, some critics still argue that copyright law restricts speech.¹⁴⁷ First Amendment protections, however, already exist in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas.¹⁴⁸ Also, the Supreme Court has made clear that the First Amendment is not a shield for copyright infringement, explaining that any tension that may lie between free speech and copyright law can be properly addressed by the fair use doctrine.¹⁴⁹

The fair use doctrine in copyright law is more flexible than the statutory fair use defense for trademark dilution by tarnishment.¹⁵⁰ Pursuant to section 107 of the Copyright Act, fair use of a copyrighted work is not an infringement.¹⁵¹ Although a descriptive or nominative use of a mark is automatically considered fair use under the TDRA, fair use un-

¹⁴³ 17 U.S.C. §§ 102(a), 106A (2006) (providing that works of authorship include literary, musical, pictorial, and graphic works among others); Goldsmith, *supra* note 36, at 826; Roe, *supra* note 13, at 604 (comparing tarnishment coverage with copyright law's moral rights doctrine). *But see* Roe, *supra* note 13, at 571 (noting that unlike copyrights, trademarks do not offer the mark owner a monopoly and do not benefit the public like copyrights).

¹⁴⁴ 17 U.S.C. § 106. Subject to section 102, however, an author may not copyright facts or ideas—only “‘expression’—that display[s] the stamp of the author’s originality.” *Harper & Row Publishers, Inc.*, 471 U.S. 539 at 547; *see* 17 U.S.C. § 102(a). The dividing line between idea and expression strikes a proper balance between the Copyright Act and the First Amendment because it protects expression and allows the dissemination of facts and ideas. *See Harper & Row Publishers*, 471 U.S. at 556.

¹⁴⁵ *See Sony Music Entm’t Inc. v. Does 1–40*, 326 F. Supp. 2d 556, 565 (S.D.N.Y. 2004).

¹⁴⁶ *See Harper & Row Publishers*, 471 U.S. at 546–47. The rights conferred by copyright are designed to assure these contributors to society a fair return for their work. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). The Constitution states, “The Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8.

¹⁴⁷ *See* Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 165–66 (1998).

¹⁴⁸ *See Harper & Row Publishers*, 471 U.S. at 547, 556.

¹⁴⁹ *See id.* at 547.

¹⁵⁰ *See Koons*, 960 F.2d at 308. Fair use under the TDRA includes nominative and descriptive use; both are affirmative defenses that require no balancing test. *See* 15 U.S.C. § 1125(c) (3) (A) (2006).

¹⁵¹ 17 U.S.C. § 107 (2006).

der copyright law is determined through a four-factor balancing test.¹⁵² These factors are (1) the purpose and character of the use, (2) the nature of the copyrighted work, (3) the amount of the portion used, and (4) the effect the use has upon the potential market for or value of the copyrighted work.¹⁵³

B. Artist Failing Under a Fair Use Defense: *Rogers v. Koons*

The U.S. Court of Appeals for the Second Circuit's 1992 decision *Rogers v. Koons* illustrates the superior treatment that copyright owners may receive under copyright law as opposed to trademark holders under dilution by tarnishment law.¹⁵⁴ In that case, an artist, Jeff Koons, was found liable for copyright infringement for using a copyrighted photograph as the basis of his sculpture.¹⁵⁵ Art Rogers, a photographer of little renown, brought suit against Jeff Koons.¹⁵⁶ He accused Koons of infringement of his copyrighted photograph "Puppies" from which Koons, aware of the copyright, created his sculpture "String of Puppies."¹⁵⁷ Koons displayed the sculpture at a gallery and sold four copies of the work.¹⁵⁸ Rogers satisfied the prima facie elements of the claim—that he owned the copyright and that Koons copied the protected material without authorization.¹⁵⁹ Then, the court held that Koons's use was not exempt from liability under the fair use doctrine.¹⁶⁰

Under the first fair use factor—purpose and character of the use—the court examined the commercial nature of Koons's work and whether it was a parody or satire.¹⁶¹ In finding that Koons's sculpture was commercial in nature, the court noted that copies made for "commercial or profit-making purposes are presumptively unfair."¹⁶² The "crux of the profit/nonprofit distinction is *not whether the sole motive of the use is monetary gain* but whether the user stands to profit from exploi-

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Compare* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003) (holding that an artist using the Barbie trademark is protected from a dilution by tarnishment claim), *with Koons*, 960 F.2d at 301 (holding that an artist copying a photographer's work is liable for copyright infringement).

¹⁵⁵ *See Koons*, 960 F.2d at 303.

¹⁵⁶ *Id.* at 303–05.

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 305.

¹⁵⁹ *See id.*

¹⁶⁰ *Id.* at 308.

¹⁶¹ *Koons*, 960 F.2d at 309.

¹⁶² *Id.* (citing *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449 (1984)).

tation of the copyrighted material without paying the customary price.”¹⁶³ Despite the artistic nature of Koons’s sculpture, he profited from the copying so the court held that his use was commercial in nature and against a finding of fair use.¹⁶⁴ Conversely, under the TDRA interpretation of commerciality, a court would find Koons’s work as noncommercial because of dilution law’s focus on whether the work is *purely* commercial.¹⁶⁵

Having deemed the sculpture commercial, the court turned to the next question under the first factor: whether the work was a parody of the copyrighted photograph.¹⁶⁶ The court defined parody as when an artist, for comic effect or social commentary, closely imitates the style of another artist, creating a new artwork that ridicules the style and expression of the original.¹⁶⁷ The court acknowledged that the criticism in parodic works fosters creativity and free expression, but held that for a work to be a parody, the copied work must be at least in part an object of the parody.¹⁶⁸ The court concluded that although the work was a satirical critique of our materialistic society, it did not necessarily parody Rogers’s photograph itself.¹⁶⁹

This parody analysis bears no resemblance to that of the parody analysis in the trademark dilution cases.¹⁷⁰ Here, the court asked whether the potential infringer used the copied work as the target of

¹⁶³ See *id.* (emphasis added) (quoting *Harper & Row Publishers*, 471 U.S. at 562). The logic underlying this analysis is opposite that in determining whether a work is noncommercial in a dilution by tarnishment claim where a work is deemed noncommercial if it *does any more* than propose a commercial transaction. See *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008).

¹⁶⁴ *Koons*, 960 F.2d at 309.

¹⁶⁵ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002).

¹⁶⁶ *Koons*, 960 F.2d at 309–10.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 310.

¹⁶⁹ *Id.* The remaining three factors all militated against a finding of fair use. See *id.* at 309. The second factor—the nature of the copyrighted work—led the court to conclude that it went against fair use because the copyrighted work was one of original expression that Rogers used to gain a financial return. *Id.* The third factor included the amount and substantiality of the work used. *Id.* at 308, 310–11. The copied work was the essence of Koons’s photograph and also militated against a finding of fair use. *Id.* at 310–11. The last factor—the effect of the use on the market value of the original—led the court to conclude that Koons’s intention to create String of Puppies to generate high profits would harm future earning potential of Rogers’s photograph. *Id.* at 311–12.

¹⁷⁰ Compare *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007) (defining parody as a form of entertainment “conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner”), with *Koons*, 960 F.2d at 310 (stating that the copied work must be an object of the parody).

the parody, otherwise “there would be no need to conjure up the original work.”¹⁷¹ In the trademark dilution context, on the other hand, a parody is defined as a form of entertainment conveyed by juxtaposing the representation of the mark with the image created by the owner.¹⁷² Nothing in the trademark dilution version of parody requires that the mark be the target of the parody.¹⁷³

III. ARTISTIC EXPRESSION AND THE RIGHT OF PUBLICITY

As with trademark dilution, trademark infringement, and copyright infringement, there is an inherent tension between one’s right of publicity and the right to freedom of expression under the First Amendment.¹⁷⁴ This Part examines the manner in which courts balance the right of publicity with First Amendment concerns in cases of artistic expression.¹⁷⁵

A. *Right of Publicity and Artistic Expression*

Like copyright and trademark law, the right of publicity is an intellectual property right.¹⁷⁶ Unlike the federal copyright and trademark protections, however, the right of publicity is only recognized at state law.¹⁷⁷ It has been defined as the “inherent right of every human being to control the commercial use of his or her identity.”¹⁷⁸ The right of publicity protects the time and energy one spends in building a name and image, and a violation of this right occurs when someone uses recognizable characteristics of an individual’s persona on products or for advertising or selling such products without permission.¹⁷⁹

About half the states explicitly recognize a right of publicity,¹⁸⁰ and when a plaintiff’s identity is used in an expressive work, courts have

¹⁷¹ See *Koons*, 960 F.2d at 310.

¹⁷² See *Haute Diggity Dog*, 507 F.3d at 260.

¹⁷³ *Id.*

¹⁷⁴ See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003).

¹⁷⁵ See *infra* notes 176–201 and accompanying text.

¹⁷⁶ See 5 MCCARTHY, *supra* note 15, § 28:41.

¹⁷⁷ See *ETW Corp.*, 332 F.3d at 919; *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003).

¹⁷⁸ See *ETW Corp.*, 332 F.3d at 928.

¹⁷⁹ See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 801 (Cal. 2001); Thomas Phillip Boggess, *Cause of Action for an Infringement on the Right of Publicity*, in 31 CAUSES OF ACTION 2D 121, 144 (Clark Kimball & Mark Pickering eds., 2006).

¹⁸⁰ *Publicity*, LEGAL INFO. INST., <http://www.law.cornell.edu/wex/Publicity> (last visited Feb. 11, 2012).

balanced an individual's proprietary right of publicity with an artist's First Amendment right to free expression.¹⁸¹ California, for example, has used a "transformative" test to determine whether an artist added enough new elements to his works to avoid liability under right of publicity doctrine.¹⁸² When the artwork is a literal depiction—lacking any transformative elements—of a celebrity for commercial gain, the right of publicity of the celebrity outweighs the expressive interests of the artist.¹⁸³

Just as companies have a right to control their marks and creators of original works hold rights to their ideas, every human being has the right to control the commercial use of his identity.¹⁸⁴ In this respect, trademark dilution theory's attempt to protect the goodwill investment of mark holders finds its parallel in the right of publicity's purpose of safeguarding the individual's "enjoyment of the fruits of her labors . . . and preventing unjust enrichment."¹⁸⁵ Despite these similar interests, there is a more carefully constructed balance between the right of publicity and the First Amendment than in dilution by tarnishment where the Lanham Act ingrain its First Amendment protections through statutorily defined affirmative defenses.¹⁸⁶

Another difference in the two doctrines lies in the fame of the celebrity or mark.¹⁸⁷ Unlike the TDRA, in right of publicity doctrine there is no fame requirement that a claimant must meet to have a cause of

¹⁸¹ See *ETW Corp.*, 332 F.3d at 931; *Parks*, 329 F.3d at 461; *Comedy III Prods.*, 21 P.3d at 810; 5 McCARTHY, *supra* note 15, § 28:41. But see Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 Hous. L. Rev. 903, 929 (2003) (opposing the right of publicity as unconstitutionally constricting the right to free speech). These balancing tests vary from state to state yet serve the same purpose of balancing the state law interest with the interest in free expression. 5 McCARTHY, *supra* note 15, § 28:41. One court has used a "predominant use" test which examines whether the predominant use of the work is commercial or expressive. See *Doe v. McFarlane*, 207 S.W.3d 52, 57, 59 (Mo. Ct. App. E.D. 2006) (holding that the defendant's comic book, which featured a fictional character based on a professional hockey player, was not protected as free speech because the primary use of the plaintiff's identity was commercial and not expressive).

¹⁸² See *Comedy III Prods.*, 21 P.3d at 808–10. In addition to the transformative test, First Amendment concerns are also met by a California statute that exempts from right of publicity claims any use in connection with news, public affairs, sports broadcast, or political campaign, as well as expressive works such as plays, newspapers, films, and single and original works of art. CAL. CIV. CODE § 3344.1 (West 2011).

¹⁸³ See *Comedy III Prods.*, 21 P.3d at 808.

¹⁸⁴ See *ETW Corp.*, 332 F.3d at 928.

¹⁸⁵ See *id.* at 954; Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 54 (1994).

¹⁸⁶ See 15 U.S.C. § 1125(c) (3) (A) (2006); *ETW Corp.*, 332 F.3d at 931, 937–38 (weighing Tiger Woods's right of publicity against an artist's work, and finding in favor of the artist).

¹⁸⁷ See 15 U.S.C. § 1125(c) (2) (A); Bogges, *supra* note 179, at 144, 179.

action.¹⁸⁸ The level of fame is simply an indicator of how much damage defendant's use will do to the commercial value of that persona.¹⁸⁹

Each doctrine's analysis of commerciality also differs.¹⁹⁰ In both right of publicity and trademark dilution law, an artist does not lose First Amendment protection just because part of the artist's expressive work was created for a commercial purpose.¹⁹¹ But unlike dilution by tarnishment, if a work is deemed a form of noncommercial speech in a right of publicity claim, it is not immediately immune from liability.¹⁹²

B. *Noncommercial Yet Unprotected?: A Test for Transformity in*
Comedy III Productions v. Gary Saderup, Inc.

In *Comedy III Productions, Inc., v. Gary Saderup, Inc.*, the California Supreme Court in 2001 found that the First Amendment did not protect an artist's work despite being noncommercial speech.¹⁹³ The court used the "transformative" test to balance the right of publicity with First Amendment concerns.¹⁹⁴ There, a production company that owned the rights to the Three Stooges comedy act sued an artist for his depiction of the Three Stooges which was reprinted as lithographs and on t-shirts for sale.¹⁹⁵ Although the court acknowledged that the portraits were sold for financial gain, it categorized them as noncommercial speech.¹⁹⁶ Nevertheless, the court noted that not "all expression that trenches on

¹⁸⁸ See Boggess, *supra* note 179, at 144 (listing elements of a right of publicity claim and not including any fame requirement), 179 (noting that damages for infringement can be determined for both famous and unknown people).

¹⁸⁹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). Another difference between the two areas of law is that in right of publicity cases, even if the infringing work is expressive, such uses may not be protected if the name or likeness is only used to attract attention to a work unrelated to the identified person. See *ETW Corp.*, 332 F.3d at 930–31. Similarly, unlike dilution law where parody has been statutorily added as a defense, whether parody can serve as a defense to right of publicity claims is a controversial issue. See 5 MCCARTHY, *supra* note 15, § 28:41.

¹⁹⁰ See *infra* notes 191–192 and accompanying text.

¹⁹¹ See *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001); *Comedy III Prods.*, 21 P.3d at 802. Any commercial aspects that are "inextricably entwined" with a work's expressive elements will not make the work ineligible for First Amendment protection as free speech. See *Hoffman*, 255 F.3d at 1185 (quoting *Gaudiya Vaishnava Soc'y v. City & Cnty. of S.F.*, 952 F.2d 1059, 1064 (9th Cir. 1990)).

¹⁹² See *Comedy III Prods.*, 21 P.3d at 804; *infra* notes 193–201 and accompanying text.

¹⁹³ See 21 P.3d at 811.

¹⁹⁴ *Id.* at 808.

¹⁹⁵ *Id.* at 800.

¹⁹⁶ See *id.* at 802 (finding that an expressive work will not lose constitutional protection if it was done for financial gain).

the right of publicity receives such protection.”¹⁹⁷ Rather than immediately shielding the expressive works under the First Amendment, the court looked to the fair use doctrine from copyright law, focusing on the first factor of that test: “purpose and character of the use.”¹⁹⁸ Drawing on the first factor, the court turned its inquiry to whether the artist’s work was transformative.¹⁹⁹ Applying this “transformative” test to the facts, the court held that the artist’s images of the Three Stooges were not protected by the First Amendment because they were literal depictions lacking any transformative elements.²⁰⁰ Thus for the right of publicity, First Amendment protection can be raised as a defense for non-commercial works, but under the “transformative” test, only to the extent that the expressive work contains transformative elements.²⁰¹

IV. DEFICIENCIES IN THE CURRENT ANALYTICAL FRAMEWORK FOR DILUTION BY TARNISHMENT

Under current dilution law, artist Max Papeschi would wrongly avoid liability for his abuse of Disney trademarks in his art.²⁰² The rather stark contrast of a Disney trademark juxtaposed with a swastika is strikingly tarnishing to the Disney icon.²⁰³ The artist has even said that his Mickey Mouse loses its “reassuring effect and change[s] into a collective nightmare” in his work.²⁰⁴

¹⁹⁷ *Id.* at 804.

¹⁹⁸ *Id.* at 808. This test is based on the first factor of the copyright fair use test—“purpose and character of the use”—because the purpose of that factor is to see if the new work adds something new and whether it is transformative. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 569 (1994).

¹⁹⁹ *See Comedy III Prods.*, 21 P.3d at 808 (noting that the purpose of the fair use factor is to see whether the work imbues the original work with new expression or meaning). The court believed the transformative quality of a work appropriately balanced the right of publicity with the First Amendment because the less transformative and more literal an artistic work is, the more the state’s interest in protecting an individual’s right to publicity outweighs the interests of the imitative artist. *See id.*

²⁰⁰ *Id.* at 811.

²⁰¹ *See id.* at 810; *see also ETW Corp.*, 332 F.3d at 937–38 (concluding that under the transformative test, Tiger Woods’s right of publicity is outweighed by the First Amendment rights of an artist who added significant creative elements to his painting, which was sold in limited-edition prints and featured Tiger Woods).

²⁰² *See* 15 U.S.C. § 1125(c) (2006). By referring to Papeschi’s work, I am simply providing a visual example of an artist’s tarnishing use of a trademark and am not implying that the FTDA applies extraterritorially.

²⁰³ *See id.* § 1125(c) (2)(C).

²⁰⁴ *See* Grieshaber, *supra* note 2.

Despite clear tarnishment, no remedy would exist for Disney under the TDRA.²⁰⁵ In copyright law, if an original work is copied by an artist for purposes of criticism or comment, the use may be a fair use, but it is first subject to a four-factor test.²⁰⁶ In right of publicity cases, courts balance the right of publicity with First Amendment interests, using tests such as the transformative test from the California Supreme Court's decision *Comedy III Productions v. Gary Saderup, Inc.* in 2001.²⁰⁷ There is no such analysis in dilution by tarnishment cases.²⁰⁸ Instead, the broad defenses under the TDRA purportedly balance the public's interest with that of the mark owners.²⁰⁹ Despite this built-in balancing of conflicting interests, however, application of the TDRA to expressive works will lead to an uneven balancing toward the artist.²¹⁰ There are several facets of the TDRA that make it unable to properly regulate expressive works.²¹¹

This Part highlights the ineffectiveness of the TDRA in regulating expressive works by examining four parts of the statute that make it inapplicable to uses outside the mainstream commercial market.²¹² Section A explains how the trademark use requirement allows artists to escape liability.²¹³ Section B discusses the "famous mark" requirement as a barrier for mark holders of lesser known marks.²¹⁴ Section C suggests that under the courts' interpretations of the noncommercial use exemption, works of art will be protected from the statute's scope despite their place in a commercial art world.²¹⁵ Section D explains how the nominative fair use defense does not belong in tarnishment law and how this defense, as well as parody, tilts the TDRA in favor of artists.²¹⁶

²⁰⁵ See 15 U.S.C. § 1125(c).

²⁰⁶ See *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992).

²⁰⁷ See 21 P.3d 797, 808 (Cal. 2001).

²⁰⁸ See 15 U.S.C. § 1125(c)(2)(C).

²⁰⁹ See Lockridge, *supra* note 13, at 369; Roe, *supra* note 13, at 585.

²¹⁰ See Gulasekaram, *supra* note 10, at 887.

²¹¹ See *infra* notes 217–286 and accompanying text.

²¹² See *infra* notes 217–286 and accompanying text.

²¹³ See *infra* notes 217–232 and accompanying text.

²¹⁴ See *infra* notes 233–247 and accompanying text.

²¹⁵ See *infra* notes 248–263 and accompanying text.

²¹⁶ See *infra* notes 264–286 and accompanying text.

A. Use of Trademark Deficiency

The first way in which the TDRA allows artists to escape liability at the expense of mark holders is the trademark use requirement.²¹⁷ To be liable for dilution, defendants must use marks as trademarks.²¹⁸ Artists, however, use marks expressively and not as source indicators for their own artwork.²¹⁹ An example of an artist using a famous trademark in a non-trademark manner is one who depicts Barbie in his photographs for purely artistic purposes rather than as a brand for his photographs.²²⁰ Similarly, Max Papeschi used the Mickey Mouse head not to serve as a trademark for his own work, but to comment upon society in an artistic manner.²²¹ Conversely, an example of a trademark use is a coffee retailer using “Charbucks” marks on their coffee products, serving as a brand name for the coffee company’s retail products.²²² The TDRA’s limitation to trademark uses ignores the fact that non-trademark uses (such as Papeschi’s Mickey Mouse) are just as dilutive as trademark uses.²²³ Nevertheless, in the case of “NaziSexyMouse,” Papeschi’s tarnishing use would fall outside the scope of the statute because his depiction of the Mickey Mouse mark does not function as a trademark.²²⁴

The shield of artistic works resulting from a prohibition limited to trademark uses thwarts tarnishment theory’s broader goal—preventing the portrayal of a mark in an unwholesome context that tarnishes the reputation and goodwill investment in the famous mark.²²⁵ As consumer confusion is not the backbone to dilution theory, there is no rea-

²¹⁷ See Burstein, *supra* note 7, at 1226 (discussing that under the TDRA only use as a mark or trade name is actionable).

²¹⁸ See *id.*

²¹⁹ See *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 796 (9th Cir. 2003) (noting that the defendant used images of Barbie for purposes of social and political overtones); Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1210 (2006) (describing an artist who drew a Volkswagen “bug” composed of insect parts as a visual pun).

²²⁰ *Walking Mountain Prods.*, 353 F.3d at 796. The appearance of Barbie in the photographs was actually an issue of trade dress that refers to the visual appearance of a product that signifies its source. *Id.* at 808. In addition to trademark dilution, the TDRA also applies to trade dress dilution. 15 U.S.C. § 1125(c)(4) (2006).

²²¹ See *Brothers*, *supra* note 1.

²²² *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 103 (2d Cir. 2009).

²²³ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901, 903–04 (9th Cir. 2002) (reasoning that although exempt under the noncommercial use exception of the TDRA, the non-trademark use of Barbie in a song title was dilutive); *Eastman Kodak Co. v. D.B. Rakow*, 739 F. Supp. 116, 118–19 (W.D.N.Y. 1989).

²²⁴ See 15 U.S.C. § 1125(c)(1); Burstein, *supra* note 7, at 1221.

²²⁵ See *LAFRANCE*, *supra* note 6, at 206–07.

son why non-trademark uses should be considered less tarnishing than trademark uses.²²⁶ Dilution law usually applies when parties do not operate in “competitive or closely related product lines,” so the requirement that the use be as a trademark has no bearing on the level of dilution.²²⁷

The opposition to a trademark use requirement for all dilution actions in a draft of the TDRA suggests that perhaps the inclusion of a trademark use in the statutory interpretation was not even intended by Congress.²²⁸ One draft defined dilution by tarnishment as an “association arising from the similarity between a *designation of source* and a famous mark that harms the reputation of the famous mark.”²²⁹ This language in the draft was opposed as being overbroad and unnecessary, preventing claims for tarnishment when defendant’s use of the mark is not as a designation of source for its own goods.²³⁰ This language was removed before the TDRA passed in 2006, suggesting a win for trademark owners.²³¹ Despite the removal of the “source designation” language, the statute has nevertheless been read to require the use to function as a trademark, thus providing a quick and concrete shield for artists.²³²

²²⁶ See 15 U.S.C. § 1125(c)(1) (2006).

²²⁷ See *Malletier v. Dooney & Bourke, Inc.*, 561 F. Supp. 2d 368, 379 (S.D.N.Y. 2008); 4 MCCARTHY, *supra* note 15, § 24:72 (noting that anti-dilution theory was conceived to protect strong marks against a diluting use far removed from the area of commerce of the famous mark).

²²⁸ See H.R. REP. NO. 109-23, at 17–19 (2005); Burstein, *supra* note 7, at 1221.

²²⁹ See H.R. REP. NO. 109-23, at 19 (emphasis added) (adopting a requirement that for a defendant’s use to be tarnishing, the defendant must use the mark as a means of identifying his own products); Burstein, *supra* note 7, at 1221.

²³⁰ See Burstein, *supra* note 7, at 1222 (citing *Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet and Intellectual Property, Comm. on the Judiciary*, 109th Cong. 224 (2005) (statement of William G. Barber, Am. Intellectual Prop. Law Ass’n)).

²³¹ See William G. Barber, *The Trademark Dilution Revision Act of 2005: Breathing Life Back into the Federal Dilutions Statute*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1113, 1132 (2006); Burstein, *supra* note 7, at 1222.

²³² See 15 U.S.C. § 1125(c)(1) (2006) (requiring “use of a mark or trade name”); *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 112 (2d Cir. 2010); Burstein, *supra* note 7, at 1223–24. The use must be as a “mark” or “trade name” and the Lanham Act defines mark to include any name used by a person to identify his business, and trade name to include any trademark used to indicate the source of goods. 15 U.S.C. § 1125(c); *supra* notes 73–75 and accompanying text.

B. *Nationally Famous Mark Deficiency*

A second way the TDRA provides too much protection for artists is the requirement that the mark be nationally famous.²³³ By hinging fame on whether a mark “is widely recognized by the general consuming public of the United States,” the TDRA fails to cover an entire category of marks that would have received protection under the FTDA.²³⁴ Most courts no longer consider a mark famous if it is well known in merely one geographic region or a market niche.²³⁵ With the scope of fame much narrower than it was under the FTDA, mark holders with lesser known marks are unprotected despite the money and effort they invested in the selling power of their mark.²³⁶

Some scholars opine that the new fame requirement helps prevent the over protection of marks.²³⁷ As some commentators see it, the TDRA benefits mark holders by not requiring a demonstration of consumer confusion, and the fame requirement is a counterweight to this concession to mark holders.²³⁸ But the TDRA already contains a strong set of affirmative defenses that will excuse diluters from liability.²³⁹ The primary dilution by tarnishment theory of preventing the tarnishment of a mark’s quality is thwarted if regionally well-known marks are precluded from receiving TDRA protections solely on account of the national fame requirement.²⁴⁰ By no longer allowing fame in a niche market to suffice, tarnishment within a smaller scope is effectively ignored.²⁴¹

²³³ See 15 U.S.C. § 1125(c)(2); *supra* notes 76–87 and accompanying text.

²³⁴ See 15 U.S.C. § 1125(c)(2)(A); *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 908 (9th Cir. 2002) (finding plaintiff’s operation in a narrow market sufficient under the FTDA).

²³⁵ See *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 509 F.3d 380, 384 (7th Cir. 2007) (stating that the 2006 TDRA “eliminated any possibility of ‘niche fame,’ which some courts had recognized before the amendment”).

²³⁶ See *Starbucks Corp.*, 588 F.3d at 105; *Bd. of Regents, Univ. of Tex. Sys. ex rel. Univ. of Tex. at Austin v. KST Elec., Ltd.*, 550 F. Supp. 2d 657, 677–79 (W.D. Tex. 2008). Determining the level of fame has been a source of controversy and as some courts have still looked at FTDA case law to determine the strength of a mark, perhaps the appropriate standard has not yet been reached. See *Pet Silk, Inc. v. Jackson*, 481 F. Supp. 2d 824, 830 (S.D. Tex. 2007) (looking to the FTDA and holding that *Pet Silk* has name recognition in the pet supply and dog grooming market, and noting that the U.S. Court of Appeals for the Fifth Circuit has held that market fame is sufficient); *Roe*, *supra* note 13, at 601.

²³⁷ See, e.g., *Gunnell*, *supra* note 31, at 450.

²³⁸ See, e.g., *id.*

²³⁹ See 15 U.S.C. § 1125(c)(3).

²⁴⁰ See *KST Elec.*, 550 F. Supp. 2d at 675; *Schechter*, *supra* note 41, at 825.

²⁴¹ See *Burstein*, *supra* note 7, at 1217–18 (stating that several cases have already been denied relief because the plaintiff’s mark was not sufficiently famous).

It is clear that the more famous the mark is, the more that mark has at stake in terms of having its reputation tarnished, but this does not mean that national fame should be a requirement.²⁴² Proving national fame can be difficult for mark holders: for example, the U.S. District Court for the Western District of Texas held that the University of Texas's longhorn silhouette logo was not nationally famous in the 2008 case *Board of Regents, University of Texas System ex rel. University of Texas at Austin v. KST Electric Ltd.*²⁴³ Further, negative associations can still result in injury to the reputation, and thus selling power, of the mark that is merely famous in a niche market.²⁴⁴ State anti-dilution laws only require that the mark have sufficient distinctiveness and do not require the same level of fame as the TDRA.²⁴⁵ Goodwill investment in the creation and maintenance of a trademark is motivated by the expectation that all mark holders will enjoy returns from their investments.²⁴⁶ If dilution protection only extends to nationally famous marks, then mark holders in niche markets may lose the motivation to make such investments.²⁴⁷

C. Noncommercial Use Complications

The TDRA's noncommercial use exclusion is the third way the TDRA prevents mark holders from protection against artists.²⁴⁸ It is true that the Lanham Act was not intended to extend protection beyond the boundaries of commercial speech, and that expressive works are de facto forms of noncommercial speech safeguarded under the First Amendment.²⁴⁹ But new technologies and evolving methods of advertising and selling products complicate the rigid interpretation of

²⁴² Compare *Malletier*, 561 F. Supp. 2d at 391 (requiring national fame), and *Nike, Inc., v. Nikepal Int'l, Inc.*, No. 2:05cv01468-GEB-JFM, 2007 WL 2782030, at *5–6 (E.D. Cal. Sept. 18, 2007) (requiring national fame), with *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 953 (6th Cir. 2003) (noting that the possession of a right of publicity should not depend on one's celebrity status but rather that celebrity status is relevant for purposes of determining the economic value of the plaintiff's identity).

²⁴³ See *KST Elec.*, 550 F. Supp. 2d at 675.

²⁴⁴ See *id.* at 675, 678.

²⁴⁵ See *LA FRANCE*, *supra* note 6, at 208–09 (noting, however, that states have been following the trend to incorporate some “fame” requirement into their statutes in order to conform to the federal statute).

²⁴⁶ See *TONY MARTINO, TRADEMARK DILUTION* 81 (1996).

²⁴⁷ See *id.*

²⁴⁸ See *Timbers & Huston*, *supra* note 135, at 1294–95 (noting that the “purely commercial speech” reasoning could “vitiate the federal dilution statute for artistic works”); *infra* notes 249–263 and accompanying text.

²⁴⁹ See *MCA Records*, 296 F.3d at 904; *Goldsmith*, *supra* note 36, at 861.

the TDRA's noncommercial use exception.²⁵⁰ When the present non-commercial use exception is applied to "NaziSexyMouse," it is clear that Papeschi would be able to freely use the Disney mark.²⁵¹ Courts would likely acknowledge the commercial profits from the sale and advertising of Papeschi's work, but then they would also recognize that, in line with prior cases, such profits do not overpower the noncommercial aspects of the artwork.²⁵² Thus the commercial nature of Papeschi's advertisement would have no bearing on the rigid interpretation of the noncommercial use defense.²⁵³

Such an interpretation enables courts to protect, as noncommercial uses, expressive works that use a mark to generate commercial profit because their purpose is not "purely commercial."²⁵⁴ But the evolving relationship between art and commercialism renders the "purely commercial purpose" reasoning moot.²⁵⁵ As commercialism in artistic works increases, this boundary between commercial and noncommercial uses blurs, making it harder to determine the primary purpose in creating the work.²⁵⁶ An expressive work with some commercial purpose should no longer be automatically exempted under the TDRA as "noncommercial."²⁵⁷ Artworks which generate millions in revenue via public auctions and commercial advertising should receive the same treatment as a company using a mark for commercial, advertising purposes.²⁵⁸ In today's world, artists stand to profit from their creations, and at times this profit is at the expense of the holders of famous marks.²⁵⁹ With such a

²⁵⁰ See *MCA Records*, 296 F.3d at 906 (noting that the line between commercial and noncommercial speech is not clearly delineated); Gulasekaram, *supra* note 10, at 887, 933, 940 (discussing the increasingly commercial role of film and the pressure it places on the commercial/noncommercial boundary); Joern, *supra* note 6, at 293.

²⁵¹ See *Walking Mountain Prods.*, 353 F.3d at 812; *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1309 (N.D. Ga. 2008).

²⁵² See *MCA Records*, 296 F.3d at 905–06; *Smith*, 537 F. Supp. 2d at 1339.

²⁵³ See *Walking Mountain Prods.*, 353 F.3d at 812; Lockridge, *supra* note 13, at 355–56.

²⁵⁴ See *Walking Mountain Prods.*, 353 F.3d at 796; *MCA Records*, 296 F.3d at 905; Gunnell, *supra* note 31, at 455–56.

²⁵⁵ See *infra* notes 256–263 and accompanying text.

²⁵⁶ See Gulasekaram, *supra* note 10, at 941–42; *Auction Results for Damien Hirst's Beautiful Inside My Head Forever Evening Sale*, SOTHEBY'S, http://www.sothebys.com/app/live/lot/LotResultsDetailList.jsp?event_id=28883&sale_number=L08027 (last visited Mar. 1, 2012). In 2008, Sotheby's held an evening sale for the works of one contemporary artist, Damien Hirst. See *id.* The artist earned £70,545,100 for the sale of his works alone. See *id.*

²⁵⁷ See Kinsella, *supra* note 105, at 98–99.

²⁵⁸ See *id.* at 98–99, 103 (noting the way in which contemporary artists treat their works as brands).

²⁵⁹ See *Walking Mountain Prods.*, 353 F.3d at 812; *Parks v. LaFace Records*, 329 F.3d 437, 441 (6th Cir. 2003).

broad exception applying to all expressive works, even those with commercial aspects, artists will escape liability until courts become cognizant of the commercially evolving market for art.²⁶⁰ Unless courts do that, the noncommercial use exception will pose a problem and should either be eliminated from the TDRA as an affirmative defense or used as a factor in a fair use balancing test.²⁶¹ By retaining noncommercial use as an affirmative defense, Congress has predetermined that the expressive value of a work containing some commercial aspects always outweighs the risk of commercial harm.²⁶² This predetermination is not only premature in light of the fuzzy line between commercial and noncommercial uses, but an outlier in the field of intellectual property.²⁶³

D. *The Parody and Nominative Fair Use Deficiency*

Not only is the noncommercial use exception unnecessarily blocking mark holders from protection, but the addition of parody as an affirmative defense also renders the noncommercial use defense redundant in the context of expressive works.²⁶⁴ Under the FTDA, there was no parody exception so courts used the noncommercial use exception as a tool to protect parodies from liability.²⁶⁵ Although parody is its own exception today, courts still use the noncommercial use exception to protect parodies.²⁶⁶ But parody's possession of its own affirmative de-

²⁶⁰ See *L.L. Bean, Inc. v. Drake Publ'g, Inc.*, 625 F. Supp. 1531, 1537–38 (D. Me. 1986) *rev'd sub nom.* *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987) (finding that plaintiff's trademark is in the nature of a property right and does not need to yield to First Amendment rights, and that if injunctive relief were not available to prevent dilution of a trademark, then any unauthorized use of a mark would be without remedy). The original 2005 bill did not contain the noncommercial use exception. H.R. REP. NO. 109-23, at 2. Instead, the draft bill contained a parody exception, and a representative stated that it adequately managed to balance the rights of trademark holders and the First Amendment. See 151 CONG. REC. 2123 (2005); Lockridge, *supra* note 13, at 350 (noting that although the bill did not have a noncommercial use exception, it had an exclusion for parodying, criticizing, or commenting upon the mark). Advocates of the bill containing only the parody exception believed the noncommercial use exception was precarious in its calling for courts to distinguish commercial and noncommercial speech. See Joern, *supra* note 6, at 293.

²⁶¹ See *Koons*, 960 F.2d at 308; *Comedy III Prods.*, 21 P.3d at 804.

²⁶² See Lockridge, *supra* note 13, at 369.

²⁶³ See *Koons*, 960 F.2d at 308; *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Comedy III Prods.*, 21 P.3d at 804.

²⁶⁴ See 15 U.S.C. § 1125(c)(3) (2006); Joern, *supra* note 6, at 293–95.

²⁶⁵ See 15 U.S.C. § 1125(c)(4) (2000), *amended by* 15 U.S.C. § 1125(c)(3) (2006); *Walking Mountain Prods.*, 353 F.3d at 812.

²⁶⁶ See *Smith*, 537 F. Supp. 2d at 1339–40.

fense renders continued judicial reliance on the noncommercial use exception both unnecessary and unfair to mark holders.²⁶⁷

An additional implication of the parody exclusion arises from the unclear interpretation of parody resulting in an unfair benefit to defendants over mark holders.²⁶⁸ Courts have varied in their interpretations of parody, allowing artists to grasp onto the defense even if their work does not specifically parody the famous mark.²⁶⁹ The inclusion of parody under the fair use umbrella provides blanket coverage to artists.²⁷⁰ Now that parody is a separate affirmative defense to dilution claims, courts must consistently apply the defense.²⁷¹ Too broad an interpretation of parody will allow any artist to “cry parody” at the mark holder’s expense.²⁷² First, courts must understand that according to the text of the TDRA, use of a mark as a source identifier should preclude parody as fair use.²⁷³ Secondly, unsure of whether the mark must be the target or weapon of the parody, courts may find for defendants who used famous marks as *weapons* of the parody.²⁷⁴ Examining the statutory language itself and relevant case law, it seems as though courts should only apply the parody exemption when the mark is used as a target, not

²⁶⁷ See *id.* (using the noncommercial use defense only to justify parody as a defense); *TDRA Hearing*, *supra* note 88, at 36–37 (statement of Mr. Marvin J. Johnson, Legislative Counsel, ACLU) (noting that courts used the noncommercial use defense to protect parodies from liability, and thus recommending that the TDRA drop the noncommercial and commercial distinction if adopting a free speech defense such as parody).

²⁶⁸ See 15 U.S.C. § 1125(c) (3); *infra* notes 269–277 and accompanying text.

²⁶⁹ See *Walking Mountain Prods.*, 353 F.3d at 801–02, 812 (holding that Barbie photographs, which commented upon gender roles and women’s position in society, were parodies of Barbie); *Gunnell*, *supra* note 31, at 467–68. *But see Smith*, 537 F. Supp. 2d at 1316 (holding that defendant’s Wal-Ocaust and Wal-Qaeda logos commented directly upon Wal-Mart and were thus successful parodies).

²⁷⁰ See *Smith*, 537 F. Supp. 2d at 1316 (defining parody as a simple form of entertainment conveyed by the juxtaposition of the representation of the mark with the idealized image created by the mark’s owner); *Gunnell*, *supra* note 31, at 463, 465 (noting the effect of such a broad parody exception and the lack of attention courts give to defining a parody in dilution cases).

²⁷¹ See *Smith*, 537 F. Supp. 2d at 1339–40 (using parody as part of the noncommercial use exception but neglecting to recognize that the defendant was using marks to refer to his own products). *But see Starbucks Corp.*, 588 F.3d at 112 (recognizing that the parody exception will not apply because defendant was using “Charbucks” as a designation of source for its own goods).

²⁷² See *Gunnell*, *supra* note 31, at 471 (quoting 6 McCARTHY, *supra* note 15, § 31:153).

²⁷³ See *Starbucks Corp.*, 588 F.3d at 112. The TDRA makes it clear that the defense will not apply if the mark is used as the designation of source for the defendant’s own goods or services. See 15 U.S.C. § 1125(c).

²⁷⁴ See *Gunnell*, *supra* note 31, at 468–69; *Posner*, *supra* note 125, at 67–68.

a weapon.²⁷⁵ As presently constituted, courts applying the TDRA may allow a parodist to use the holder's mark in a fashion harmful to the mark simply because the parodist is satirizing or commenting upon society, rather than the mark itself.²⁷⁶ Thus, artists may "escape[] judicial scrutiny" regardless of whether the use is actually a parody or the degree to which the mark is harmed.²⁷⁷ Max Papeschi, under the current judicial interpretation of parody under the TDRA, could successfully raise the parody defense.²⁷⁸ Although he does not use Disney as the "target" of his parody, courts would likely exempt his use of the Disney trademark as a parody, reasoning that Papeschi has differentiated his parody from the original mark and is using the mark as a satire to criticize American culture at large.²⁷⁹

Papeschi would also be able to escape liability under the nominative fair use defense because he used Mickey Mouse to reference the Disney brand.²⁸⁰ An artistic use of a mark is inherently nominative, as the depiction identifies the mark holder's trademark.²⁸¹ This guaranteed exclusion for artists, however, has no grounding in the dilution by tarnishment context.²⁸² Nominative use is considered fair use in trademark infringement because it does not attempt to capitalize on con-

²⁷⁵ See 15 U.S.C. § 1125(c) (requiring the parody be commenting *upon* the famous mark); *Smith*, 537 F. Supp. 2d at 1340; *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (reasoning that the similarity between Dr. Seuss's style and the parody was not warranted where the authors were not intending to actually comment on Dr. Seuss); Posner, *supra* note 125, at 71; see also Gunnell, *supra* note 31, at 468 (noting that weapon parodies provide little societal benefit because they could have conveyed their message without negatively affecting the intellectual property of the mark holder).

²⁷⁶ Gunnell, *supra* note 31, at 466–69 (discussing whether courts may interpret the statute to find that some parodies do not constitute fair use or perhaps apply an imprecise definition of parody to more generally benefit defendants).

²⁷⁷ See *id.* at 442, 467–68. The juxtaposition of dilution and parody have been coined the "dilution-parody paradox." *Id.* at 454. Underlying this paradox is the tension between parody and dilution due to the fact that the ridicule that is the object of parody conflicts with the purpose of anti-dilution law. *Id.*

²⁷⁸ See *Smith* 537 F. Supp. 2d at 1316; *supra* notes 126–129 and accompanying text.

²⁷⁹ See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007); *Smith*, 537 F. Supp. 2d at 1316; Gunnell, *supra* note 31, at 468; Posner, *supra* note 125, at 71.

²⁸⁰ See *Tiffany*, 600 F.3d at 112; *Walking Mountain Prods.*, 353 F.3d at 812. The nominative fair use defense is unnecessary due to the requirement that the use be a trademark use. See Burstein, *supra* note 7, at 1225, 1244. If the junior user must use the mark as a trademark in order to fall within the scope of the statute, then the nominative fair use exception (which exempts non-trademark uses) is irrelevant. See *id.*

²⁸¹ See *Playboy Enters., Inc., v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

²⁸² See *infra* notes 283–286 and accompanying text.

sumer confusion.²⁸³ This kind of trademark use is now an affirmative defense for dilution by tarnishment, yet consumer confusion is by no means a part of tarnishment theory.²⁸⁴ By creating a cause of action for dilution by tarnishment, Congress sought to remedy any use that encroaches upon the business *reputation* of a famous mark, not to remedy public *confusion* caused by competitors' use of that mark.²⁸⁵ If tarnishment is still a result of the defendant's use, then a nominative use that developed out of concern for consumer confusion should not have any bearing on a court's judgment.²⁸⁶

V. RECOMMENDATIONS FOR IMPROVING THE TDRA

As the TDRA will immediately shield defendants when applied to artistic works, courts should not use it in such situations.²⁸⁷ Other areas of intellectual property law more appropriately balance the property rights of plaintiffs with the First Amendment concerns of defendants.²⁸⁸ This Part suggests that a more accurate analysis of trademark dilution by tarnishment can come from a comparative look at the methods used by courts in actions based on copyright law and the right of publicity.²⁸⁹ This Part first proposes an alternative to the rigid framework of the TDRA: an alteration to the language in the cause of action for injunctive relief and a new fair use defense, similar to that of copyright law, as a substitute for the TDRA's statutory defenses.²⁹⁰ This Part

²⁸³ See *New Kids on the Block*, 971 F.2d at 308.

²⁸⁴ See 15 U.S.C. § 1125(c) (2006). In addition, a broad nominative fair use defense is unnecessary given the existence of the fair use exclusion for use of a mark in advertising or promotion that allows consumers to compare goods. See *id.* § 1125(c)(3)(A)(i); see also *New Kids on the Block*, 971 F.2d at 308 (noting that the nominative fair use defense is permissible because the junior user uses the mark in a non-confusing way to identify the mark holder's goods).

²⁸⁵ See *Eastman Kodak Co.*, 739 F. Supp. at 118–19.

²⁸⁶ See *MCA Records*, 296 F.3d at 903; *New Kids on the Block*, 971 F.2d at 308. Also, there is no uniform understanding of how the nominative fair use test will be applied. See Burstein *supra* note 7, at 1242–44.

²⁸⁷ See Rosenblatt, *supra* note 14, at 1011 (noting that trademark law permits negative depictions of marks); *supra* notes 202–286 and accompanying text.

²⁸⁸ See *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (applying the artistic relevance test in a trademark infringement case); *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992) (using a four-factor fair use test in a copyright case); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807–08 (Cal. 2001) (applying a balancing test in a right of publicity case that draws upon the fair use text in copyright law); *supra* notes 139–201 and accompanying text.

²⁸⁹ See *infra* notes 292–322 and accompanying text.

²⁹⁰ See *infra* notes 292–322 and accompanying text.

then returns to Papeschi and examines how Disney would likely succeed in obtaining an injunction under the proposed solution.²⁹¹

A. Multifactorial Fair Use Defense

The adoption of a fair use defense similar to that found in copyright law is one way to solve some of the TDRA's deficiencies.²⁹² If the use is deemed tarnishing, then the artist could raise a multifactorial fair use defense in place of the current noncommercial use and nominative/parody fair use exclusions.²⁹³

Before discussing the adoption of a fair use defense similar to copyright law, the problematic trademark use requirement and the nationally famous mark requirement must be addressed.²⁹⁴ To allow the TDRA to capture non-trademark uses, injunctive relief for tarnishing uses should apply to any "use of an image of, or similar to, a famous mark or trade name in commerce that is likely to cause dilution by blurring or tarnishment of the famous mark."²⁹⁵ Then, to allow owners of marks that are only famous in niche markets to have a claim against a diluter, the FTDA's broader famous mark requirement should be re-adopted.²⁹⁶

To address the complications with the noncommercial use and nominative fair use/parody defenses, a balancing test based on the fair use test of copyright law should replace the noncommercial use and broad fair use exclusions—except for the fair use exclusion allowing advertising or promotion permitting consumers to compare goods.²⁹⁷ In place of the over-encompassing fair use defense and separate de-

²⁹¹ See *infra* notes 323–338 and accompanying text.

²⁹² See *Koons*, 960 F.2d at 309.

²⁹³ See 15 U.S.C. § 1125(c) (3) (2006); *Koons*, 960 F.2d at 308.

²⁹⁴ See *supra* notes 217–247 and accompanying text.

²⁹⁵ See 15 U.S.C. § 1125(c)(1); *supra* notes 217–232 and accompanying text. The TDRA's definition of tarnishment would similarly be altered to read: "An association arising from the similarity between an image of a famous mark and the famous mark itself that harms the reputation of the mark." See 15 U.S.C. § 1125(c) (2) (C).

²⁹⁶ See 15 U.S.C. § 1125(c) (1) (A)–(H) (2000), *amended by* 15 U.S.C. § 1125(c) (2006); *supra* notes 76–87, 233–247 and accompanying text.

²⁹⁷ See *infra* notes 298–322 and accompanying text. The Copyright Act states that copying for purposes such as criticism or comment may constitute "fair use" subject to a four-factor test. See 17 U.S.C. § 107 (2006); *Koons*, 960 F.2d at 308. The fair use exclusion for advertising and promotion that will remain in the proposed standard should be structured as it was under the FTDA. See 15 U.S.C. § 1125(c) (4) (A) (2000), *amended by* 15 U.S.C. § 1125(c) (3) (A) (i) (2006) ("Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.").

fense for noncommercial use, the TDRA should adopt copyright's first fair use factor, the purpose and character of the use, to determine whether or not the tarnishing use was fair.²⁹⁸ Doing so would allow courts to examine noncommercial use as one factor that may constitute fair use, while also providing a clearer and more consistent definition of parody and removing trademark infringement's confusion-based nominative fair use defense.²⁹⁹

Analyzing noncommercial use as just one factor in determining fair use is preferable to the present defense because "any noncommercial use" is too broad to stand alone as a defense in an art world that is increasingly commercial, and it is duplicative given the existence of a parody exemption.³⁰⁰ In right of publicity and copyright infringement cases, an expressive work with some commercial elements is not immediately excluded from liability as it is in dilution by tarnishment.³⁰¹ Noncommercial use is instead considered when balancing competing interests.³⁰² Trademark dilution stands alone in refusing to perform a similar balancing of interests.³⁰³ Rather than automatically exclude expressive works from liability because they do more than propose a

²⁹⁸ See 17 U.S.C. § 107; *Koons*, 960 F.2d at 308. Under this factor, courts analyze noncommercial use and parody. *Koons*, 960 F.2d at 309. The exception for news reporting and news commentary should remain an explicit affirmative defense. See 15 U.S.C. § 1125(c)(3)(B).

²⁹⁹ See *Koons*, 960 F.2d at 309; *infra* notes 300–322 and accompanying text. Under this fair use test, a trademark use will usually not be protected as a fair use because most diluters who use a representation of a famous mark as their own trademark are doing so for commercial purposes in selling their products. See *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 112 (2d Cir. 2009) (describing how the "Charbucks" marks were used as a designation of source for the defendant's coffee products). This result is consistent with the TDRA's language implying that trademark uses are especially unworthy of fair use protection. See 15 U.S.C. § 1125(c)(3)(A) (excluding from fair use the use of a mark as a designation of source for the junior user's goods or services).

³⁰⁰ See Lockridge, *supra* note 13, at 355 (discussing the complicated line drawing in the context of the noncommercial use exclusion); see also *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008) (finding defendant's domain names and website merchandise analogizing Wal-Mart to Nazis and al-Qaeda were parodic works considered noncommercial speech). But see Joern, *supra* note 6, at 294–97 (citing support for the inclusion of both a noncommercial and parody exception); *supra* notes 248–267 and accompanying text.

³⁰¹ See *Koons*, 960 F.2d at 308; *Comedy III Prods.*, 21 P.3d at 804.

³⁰² See *ETW Corp. v. Jireh Publ'g., Inc.*, 332 F.3d 915, 925 (6th Cir. 2003) (balancing First Amendment rights with intellectual property rights despite the use being noncommercial); *Koons*, 960 F.2d at 309 (noting that the noncommercial aspect of *Koons*'s artwork is but one part of the first factor of the four-factor test); *Comedy III Prods.*, 21 P.3d at 804, 808 (using a "transformative" test despite having determined the work is noncommercial).

³⁰³ See *Smith*, 537 F. Supp. 2d at 1340; Lockridge, *supra* note 13, at 368–69 (discussing how Congress does its own balancing by giving defendants a general noncommercial use exclusion).

commercial transaction, tarnishment law should draw from the copyright context and allow noncommercial use to function as a factor in considering whether purpose and character of the use is fair.³⁰⁴

When analyzing noncommercial use in a multifactorial dilution test, the court should look to the doctrines of copyright and the right of publicity because both are more flexible regarding the boundary between commercial and noncommercial use.³⁰⁵ For the right of publicity, the high degree of First Amendment protection for noncommercial speech about celebrities will not necessarily outweigh an individual's right to publicity.³⁰⁶ In the copyright context, the court has explained that the "crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."³⁰⁷ Unlike dilution by tarnishment, therefore, copyright law does not monitor the commercial/noncommercial boundary by looking at the primary purpose.³⁰⁸ Instead, copyright law focuses on whether the user will profit from exploiting the copyrighted material, and considers this determination as one factor in its fair use decision.³⁰⁹

Under this purpose and use factor, courts must clarify their interpretation for what constitutes a parody.³¹⁰ Parody has not always been consistently interpreted and the TDRA does not define parody.³¹¹ Instead, parody for trademark purposes has been judicially defined as a form of entertainment conveyed by juxtaposing the representation of the trademark with the "idealized image created by the mark's owner."³¹² A parody must also express some element of satire, ridicule, joking, or amusement.³¹³ This judicial definition of parody leaves much

³⁰⁴ See *Koons*, 960 F.2d at 309; see also *Comedy III Prods.*, 21 P.3d at 808 (looking to copyright law in applying its own transformative test).

³⁰⁵ See *Koons*, 960 F.2d at 309; *Comedy III Prods.*, 21 P.3d at 804.

³⁰⁶ See *Comedy III Prods.*, 21 P.3d at 804.

³⁰⁷ See *Koons*, 960 F.2d at 309 (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)). The Court also quoted a *New York Times* critic who complained, "Koons is pushing the relationship between art and money so far that everyone involved comes out looking slightly absurd." See *id.* at 304.

³⁰⁸ See *id.* at 309.

³⁰⁹ See *id.*

³¹⁰ See *Gunnell*, *supra* note 31, at 454 (writing that there is a strong tension between dilution and parody); *infra* notes 311–317 and accompanying text.

³¹¹ See 15 U.S.C. § 1125(c) (2006); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002); *Smith*, 537 F. Supp. 2d at 1316.

³¹² See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007).

³¹³ See *id.*

leeway for artists to claim exemption from liability.³¹⁴ Although there are slight variants to this definition, each should culminate in a consistent, appropriate legal standard.³¹⁵ One scholar proposes to define “parody” as “a (1) literary or artistic work (2) that seeks to comment upon or criticize another work (3) by appropriating or mimicking elements of the original work, in order to (4) create a new artwork that makes ridiculous the style and expression of the original (5) in a humorous fashion.”³¹⁶ This definition could guide courts to reach consistent decisions of whether an artist’s work is truly a parody.³¹⁷

Part of the courts’ inconsistent application of the parody defense stems from confusion over whether the target/weapon distinction is relevant in dilution cases.³¹⁸ The statute can be read as implying that some parodies do not constitute fair use, specifically those that do not target the original mark.³¹⁹ If exclusion from liability was solely based on an artist claiming parody without determining whether the artist was actually commenting upon the mark itself, then there would be no concrete boundary to the fair use defense.³²⁰ Courts in the dilution context should analyze parodies with reference to their role as a target or weapon, and apply the parody exemption when the mark is used as a target.³²¹ Adopting the copyright understanding of parody—

³¹⁴ See Gunnell, *supra* note 31, at 471.

³¹⁵ See *id.* at 454 (writing that a universal requirement of parody is that it must convey two messages—that it is the original but also that it is not the original and is instead a parody). Compare *Haute Diggity Dog*, 507 F.3d at 260 (using the juxtaposition definition), and *Smith*, 537 F. Supp. 2d at 1316 (same), with *MCA Records*, 296 F.3d at 901 (looking at the target/weapon distinction for infringement).

³¹⁶ See Gunnell, *supra* note 31, at 466.

³¹⁷ See *id.* This parody definition would also exclude trademark uses from the fair use defense because the definition only applies to literary or artistic works. See *id.* This result is consistent with the TDRA’s fair use defense which excludes trademark uses. See 15 U.S.C. § 1125(c)(3)(A) (2006).

³¹⁸ See *Haute Diggity Dog*, 507 F.3d at 260; *MCA Records*, 296 F.3d at 901; Burstein, *supra* note 7, at 1211–12.

³¹⁹ See 15 U.S.C. § 1125(c)(3) (requiring the parody be commenting *upon* the famous mark); Gunnell, *supra* note 31, at 466; Posner, *supra* note 125, at 74 (discussing parodies in the copyright context but analogizing them to parodies in the dilution context due to their similar approach of analyzing economic consequences and not looking at source of confusion as an issue). Also, the statute already recognizes that where the parody is used as a source identifier, it is not fair use. See 15 U.S.C. § 1125(c)(3)(A)(ii).

³²⁰ See *Koons*, 960 F.2d at 310; Gunnell, *supra* note 31, at 468.

³²¹ See 15 U.S.C. § 1125(c)(3)(A)(ii) (requiring the parody be commenting *upon* the famous mark); *MCA Records*, 296 F.3d at 901; Posner, *supra* note 125, at 71; see also Gunnell, *supra* note 31, at 468 (noting that weapon parodies provide little societal benefit because they could have conveyed their message without negatively affecting the intellectual property of the mark holder).

in which the copied work must be an object of the parody—would serve this end.³²²

B. Reexamining “NaziSexyMouse” Under the Proposed Solution

Under the proposed solution, Disney would likely succeed in a dilution by tarnishment suit against Papeschi.³²³ First, it is important to understand how “NaziSexyMouse” tarnishes the Disney mark and why Papeschi should be liable for such tarnishment.³²⁴ Courts have found dilution by tarnishment in cases involving adult cartoons, illegal drugs, crude humor, and X-rated movies.³²⁵ In 2008, the U.S. District Court for the District of Georgia in *Smith v. Wal-Mart Stores, Inc.* recognized dilution by tarnishment in situations where the trademark is portrayed in an “unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.”³²⁶ It is clear from past cases that Papeschi’s use of the Disney mark, a positive brand name, in the unwholesome context of a nude woman and a swastika would be sufficiently tarnishing.³²⁷

Despite the tarnishment, some may urge that Papeschi is nonetheless deserving of First Amendment protection.³²⁸ This Note does not argue that all tarnishing uses are not deserving of protection.³²⁹ But it does argue that before presuming all artistic works deserve protection,

³²² See *Koons*, 960 F.2d at 310. Some courts seem to have reached an understanding that the parody must target the original mark. See *MCA Records*, 296 F.3d at 901 (holding so in the infringement context); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 688 (N.D. Ohio 2002).

³²³ See *infra* notes 331–338 and accompanying text.

³²⁴ See *infra* notes 325–330 and accompanying text.

³²⁵ See *Dallas Cowboys Cheerleaders*, 604 F.2d at 206; *Eastman Kodak Co. v. D.B. Rakow*, 739 F. Supp. 116, 118 (W.D.N.Y. 1989); *Original Appalachian Artworks v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1032, 1036, 1040 (N.D. Ga. 1986).

³²⁶ See 537 F. Supp. 2d at 1339.

³²⁷ See 15 U.S.C. § 1125(c)(2)(C) (2006); *Smith*, 537 F. Supp. 2d at 1339; Gunnell, *supra* note 31, at 462 (noting that courts are displeased when a trademark is associated with “lewd, rude, and unsavory characteristics” for purely commercial purposes although they are willing to provide some slack when there is some societal message). Courts have found tarnishment to occur in contexts such as those involving illicit drugs or lewd or sexual behavior. *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 387–88 (6th Cir. 2010) (“The . . . ‘association’ between a famous mark and lewd or bawdy sexual activity disparages and defiles the famous mark and reduces the commercial value of its selling power.”), *rev’d*, 537 U.S. 418 (2003); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1187 (E.D.N.Y. 1972).

³²⁸ See *Roe*, *supra* note 13, at 604–05 (noting the discomfort some scholars have with trademark dilution).

³²⁹ See *supra* notes 202–216 and accompanying text.

the rights of mark holders should be more fairly balanced with the rights of artists.³³⁰

Papeschi's work would not be shielded under the reworked TDRA.³³¹ Although the exclusions of news reporting and advertising to compare goods and services remain, Papeschi's work clearly does not fit into either category.³³² Thus the court would have to analyze the work under the multifactorial fair use defense where the noncommercial nature of "NaziSexyMouse" would be but one factor among many to determine fair use.³³³ If a court were to recognize Papeschi's large poster advertising his work and the fading line between commercial and noncommercial works in the commercial art market, then the purpose/use factor would likely weigh in favor of Disney.³³⁴ Regarding the parodic nature of the work, the court would examine "NaziSexy-Mouse" under the "parody as target" analysis.³³⁵ Papeschi explains on his website that the series is a commentary on the United States, revealing all the "horrors of the American lifestyle."³³⁶ The use of the Mickey Mouse head, therefore, is not the target of the parody, but rather a weapon to comment on the United States.³³⁷ Without Disney serving as the target of the parody, the parody fair use defense would also tilt to the mark holder's favor.³³⁸

CONCLUSION

Under the Trademark Dilution Revision Act, the property rights of the mark holder are not balanced with the free speech rights of artists. Under the current statutory framework, if a mark holder seeks injunctive relief for an artist's tarnishing use, he will fail every time. Not only does the language of the statute make it inapplicable to expressive works, but the extensive statutory defenses overcompensate for the small benefits the TDRA gives to mark holders. Other areas of intellectual property reveal that there are more adequate ways to balance these rights. Courts may use a fair use balancing test rather than apply the rigid defenses to artistic works. Either way, this Note urges Congress to

³³⁰ See Rosenblatt, *supra* note 14, at 1011.

³³¹ See *supra* notes 292–322 and accompanying text.

³³² See 15 U.S.C. § 1125(c) (3).

³³³ See *Koons*, 960 F.2d at 309.

³³⁴ See *id.*; *supra* notes 305–309 and accompanying text.

³³⁵ See *Koons*, 960 F.2d at 309–10.

³³⁶ See Brothers, *supra* note 1.

³³⁷ See Gunnell, *supra* note 31, at 468.

³³⁸ See *Koons*, 960 F.2d at 309–10.

recognize the inapplicability of the TDRA to expressive works and suggests drawing from other areas of intellectual property law to better understand the appropriate balance of property rights of mark holders with the First Amendment concerns of free speech and public expression.

ALEXANDRA E. OLSON

Appendix: Poster of “NaziSexyMouse” by Max Papeschi



Source: Kirsten Grieshaber, *Mickey Mouse with Nazi Symbol Causes Anger in Poland*, HUFFINGTON POST (July 14, 2010), http://www.huffingtonpost.com/2010/07/14/mickey-mouse-with-nazi-sy_n_645721.html